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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1953

No. 301

MAURICE A. GARBELL, INC., a corporation, and GARBELL RESEARCH FOUNDATION, a corporation,

Petitioners,

vs.

CONSOLIDATED VULTEE AIRCRAFT CORPORATION, a corporation, and AMERICAN AIRLINES, INC., a corporation,

Respondents.

PETITION FOR WRIT OF CERTIORARI to the United States Court of Appeals for the Ninth Circuit

and

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

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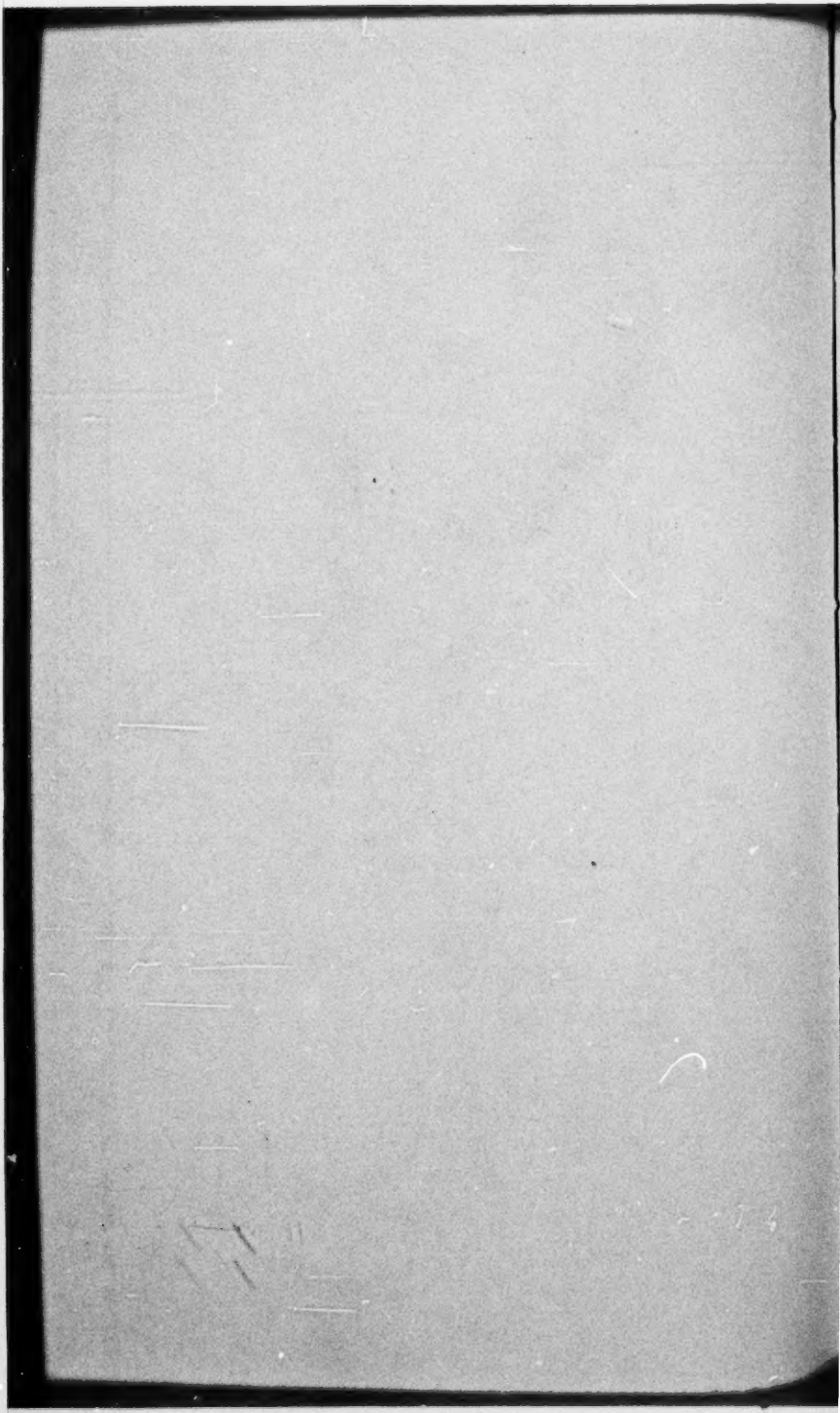

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vs.
CONSOLIDATED VULTEE AIRCRAFT CORPORATION, a corporation, and AMERICAN AIRLINES, INC., a corporation,
Respondents.

PETITION FOR WRIT OF CERTIORARI to the United States Court of Appeals for the Ninth Circuit.

To the Honorable Fred M. Vinson, Chief Justice of the United States, and to the Honorable Associate Justices of the Supreme Court of the United States:

Maurice A. Garbell, Inc., a corporation, and Garbell Research Foundation, a corporation, petitioners,

respectfully pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit entered in the above-entitled case on June 9, 1953 (R. 1148) which reversed the judgment of the United States District Court for the Southern District of California, Central Division, (R. 58; 94 Fed. Supp. 843) holding that claims 1, 2, 3, 5, 6 and 12 of patent No. 2,441,758 were valid and infringed by respondents herein, enjoined further infringement thereof, and ordered an accounting of profits and damages.

STATEMENT.

At the very outset, petitioners wish to advise the Court that, while this action was brought to recover damages for the infringement of a patent, the issues of infringement and validity are not presently involved. The only issue relates to the existence or non-existence of a so-called shop right or implied license; and it is in connection therewith that petitioners contend that the Court of Appeals clearly exceeded its proper scope of review.

Petitioners herein are the assignees of one Maurice A. Garbell, who invented the subject-matter of United States Patent No. 2,441,758, issued to him on May 18, 1948. Respondent Consolidated Vultee Aircraft Corporation (hereinafter referred to as Consolidated) is, and for many years has been, engaged in the development, design and manufacture of commercial and military aircraft. Respondent American Airlines,

Inc. is, and for many years has been, engaged in the commercial operations of aircraft for passenger and freight transportation.

Consolidated was charged with infringement as the maker of the aircraft wing used on its Model 240 "Convair" airplane, and American Airlines, Inc. was charged with infringement as the user of such aircraft, having purchased the same from Consolidated.

To the action, respondents herein interposed the defenses of non-infringement, invalidity, shop right and implied license. After a trial before it, the District Court rendered its decision in favor of petitioners herein on all issues, making special findings thereon, as hereinabove stated (R. 37; 94 Fed. Supp. 843). Respondents herein appealed to the United States Court of Appeals for the Ninth Circuit (R. 134), the cause being argued and submitted May 16, 1952, before Circuit Judges Mathews, Healy and Bone. On June 9, 1953, the Court of Appeals issued its opinion reversing the lower Court on the issues of shop right and implied license only, stating:

> "In view of the conclusions stated above, we need not and do not consider the other defenses pleaded by appellants." (R. 1148).

Thereafter, on July 8, 1953, petitioners herein duly filed a petition for rehearing with said Court of Appeals, which petition was denied on July 13, 1953 (R. 1149).

From the language taken from the opinion of the Court of Appeals and hereinabove quoted, it is apparent that the only question presented to this Court

involves the issues of shop right and implied license. The patent stands as being valid and as being infringed by respondents herein.

In order to reach the conclusion which it did, it was necessary for the Court of Appeals to hold that the special findings of the trial Court as to the non-existence of a shop right or implied license were not supported by the evidence and were clearly erroneous. Petitioners contend that the entire evidence supports the special findings of the trial Court, and that there is no evidence whatever to support the conclusion reached by the Court of Appeals, and that, therefore, the decision of the Court of Appeals constitutes an abuse of discretion (Rule 52(a) of the Federal Rules of Civil Procedure).

To resolve the question involved, turning as it does entirely upon fact, necessitates a review of the evidence, limited, however, to that portion of the evidence which in any way pertains to the questions of shop right or implied license.

It is to be noted that a major portion of the decision of the trial Court was given over to a discussion of these two issues (R. 39-43).

Although the patent is not involved herein, some understanding of the operation of the invention is desirable, for the reason that it will then become apparent to this Court that the evidence does not give support to respondents' claims of shop right or implied license.

Simply stated, the invention calls for the construction of a lifting surface (airplane wing) having three

or more sections, by the employment of airfoils selected according to the method explained in the patent, and thus achieving excellent and improved stalling characteristics. In other words, the Garbell wing is not as prone to lose its lifting power (a stall) as wings of any other type in use under similar conditions, and the Garbell wing affords a ready and complete RECOVERY to normal flight from a stall, where other types of wings lead the aircraft into a dangerous loss of altitude.

In an airplane wing, certain cross-sectional geometric shapes, called airfoils, are used to produce lift by that wing (R. 166-168). The lift is produced primarily by accelerating the flow of air over the upper surface of the wing in relation to the average speed of the wing through the surrounding air. A change in the flow of air over the upper surface of the wing can be obtained by using various selections of airfoils, which result in a change in configuration of the wing itself.

In order to have anyone skilled in the art construct a wing in accordance with the invention, it was only necessary for the inventor to give him three airfoil numbers, denoting the selection of the airfoil family, and to designate the points at which they were to be used (R. 279). The airfoils are designated by well-known NACA numbers, and the interpolation of these from one section of the wing to the next is purely a matter of computation, well understood and known to anyone skilled in the art.

Thus, in order to practice the invention, it was only necessary to construct an airplane having such

a wing and fly it. No development and no perfecting and no "trying" were necessary.

Maurice A. Garbell (hereinafter referred to as Garbell) entered the employ of Consolidated on September 7, 1942, being placed initially in Preliminary Design. He was not employed to invent. (R. 445-6).

At the time of his said employment, Garbell was requested to and did execute a form of Invention Agreement (R. 633), the pertinent portions of which are set forth in the opinion of the Court of Appeals (R. 1141-3). Said agreement required Garbell to disclose promptly in writing to Consolidated's Patent Department, or to such person as Consolidated might designate, all inventions and improvements theretofore or thereafter made, developed, perfected, devised or conceived by Garbell during Garbell's employment by Consolidated and including a period of one year after termination of employment. The inventions covered were those which related in any way to aviation or to the business, developments or products of Consolidated. The agreement outlined a procedure which, if followed, would enable Consolidated to acquire an interest in the invention. In so far as shop right is concerned, said agreement contained the following paragraph:

> "6. If [Consolidated] shall fail to elect in writing that it desires to prosecute a patent application on any invention or improvement specified in paragraph 1 hereof within nine months following disclosure thereof to [Consolidated], then all rights of [Consolidated] in and to such

> invention or improvement shall revert to [Garbell] with the exception only that [Consolidated] shall have a free shop right with respect thereto."

Obviously, then, unless an invention had been *made, developed, perfected, devised or conceived* by Garbell during employment and had been disclosed to Consolidated under the so-called Invention Agreement, there was no way by which Consolidated could have obtained a shop right under the agreement itself. If there were no rights obtained by Consolidated under the agreement itself, in order to obtain an equitable right by way of implied license it was necessary for Consolidated to establish the existence of those elements of the implied license rule, that is, when the employee (1) conceives or devises some process, method or instrument; (2) uses or causes to be used the property and other employees of his employer to develop, perfect or make or put into practicable form his invention; and (3) assents to or acquiesces in the use by the employer of such invention.

The only matter open for decision at this point is whether or not Garbell's invention was *made, developed* or *perfected* during employment. The trial Court found that said invention was *devised* and *conceived* by Garbell prior to his employment, which finding the Court of Appeals found to be supported by the evidence and, therefore, accepted said finding as correct. (R. 1146).

Shortly after the date of his employment by Consolidated, Garbell suggested to his employer the use of

his invention. (R. 446). This procedure was followed by him upon many occasions until his employment terminated on October 15, 1945. Each and every of said proposals were turned down by Consolidated (R. 234-237; 261; 278-279; 301-302; 313-314; 324-326; 362; 461; 40-43). At no time did Consolidated offer to use the invention, and at no time did the corporation use the invention until long after Garbell had left its employment, and then such use was without his knowledge or consent (R. 236-237; 249; 255-257; 326; 418; 457-459).

Garbell was thoroughly familiar with the procedure to be followed in order to disclose an invention to Consolidated under the Invention Agreement, and he was entirely familiar with the steps which were taken by Consolidated under said Invention Agreement following the disclosure of an invention by an employee. During the course of his employment, seven inventions made by Garbell were submitted to Consolidated under the Invention Agreement, some of which were accepted and some of which were rejected by Consolidated (R. 283; 351; 353; 316-322; 447-448).

Inasmuch as the evidence in this case demonstrates that the invention of Garbell was never *made, developed* or *perfected* during the time of his employment by Consolidated, it would not be, and was not, possible for Consolidated to obtain an express shop right under the Invention Agreement relating to the use of said invention. This statement is likewise true for the additional reason that there never was a dis-

closure of the invention by Garbell to Consolidated under the Invention Agreement or within its terms and provisions.

No implied license could be, nor was it, obtained by Consolidated for the reason that Garbell's invention was not *made, developed, perfected, devised* or *conceived* by Garbell during employment.

In the decision rendered by the Court of Appeals, there is no definite holding that Garbell made, developed or perfected his invention during his employment. Repeatedly said Court uses the language: "The evidence showed that, if Garbell ever made, developed or perfected his invention he did so during his employment by Consolidated". This is an assumption by the Court without basis, for there is no evidence that said invention was ever made, developed or perfected by and through the use of materials or facilities of Consolidated or time for which Garbell was paid by Consolidated.

The Court of Appeals assumed that solely because Consolidated, upon a few occasions during the period of Garbell's employment, had caused certain wing models to be made for its own purposes and which did embrace the features of the Garbell invention, that this constituted either a making, a developing or a perfecting of said invention, or a reduction to practice. Such an assumption is not correct and cannot find support in the evidence.

The character of this invention has heretofore been stated (supra, p. 4), and it is obvious that said in-

vention is not one which calls for a process or a machine or a design. Inventions of the type last mentioned usually need work and trial-and-error methods, models need to be made, and so the development or perfecting of the invention progresses step by step.

The uncontroverted fact is that the invention as ultimately used by Consolidated after Garbell had terminated his employment with Consolidated, was unchanged from the first suggestion for its use as made by Garbell several years before and shortly after his employment by Consolidated on September 7, 1942. Respondents herein introduced no evidence whatsoever which even tended to show that during Garbell's employment the invention was changed, developed or perfected. The only testimony in the record on the subject was introduced by petitioners positively stating that there was no change in the invention by anything that was done during the period of employment of Garbell (R. 461-462).

Reference has been made to models constructed by Consolidated which embodied the invention. The uncontroverted evidence is to the effect that no model contained all of the elements of the invention and fully operated so that the teaching of the invention could be demonstrated. Thus, there was no use made of the invention and it was not reduced to practicable form within the meaning of the authorities. To reduce the invention to practice, a model would have had to contain all the elements of the invention and be a fully-operating and free-flying model, so that the operation of the invention could be fully and com-

pletely demonstrated. One of the basic elements of the invention is that it enables an airplane using a wing constructed in accordance with the teachings of the invention to recover from a stall. Therefore, freedom of movement and the availability of operating controls were vitally necessary to demonstrate these basic elements. Such a model was never built by Consolidated.

In some instances, more than one model was built of a certain contemplated airplane. Many of these models were fixed or static models and some were free-flying. In every instance, however, the free-flying model did not make use of the Garbell invention. Strangely enough, the testimony placed in the record by petitioners herein and by respondents herein is in full accord on this subject (R. 255-7, 300, 322-3, 454-6, 458-9).

It is the contention of petitioners herein that the invention here involved belongs to that category of inventions complete in and of themselves, and that it only takes the explanation thereof to anyone skilled in the art to enable the invention to be reduced to practice. This, of course, is the so-called constructive reduction to practice rule; but the Courts, in certain instances, have upheld the theory of constructive reduction to practice over a physical reduction to practice (*Curtiss Aeroplane & Motor Corp. v. Janin* (C.C.A. 2), 278 Fed. 454, 456). A constructive reduction to practice is sufficient to protect an inventor against a claim of shop right. The evidence on this subject stands alone and uncontradicted, and demon-

strates that long prior to Garbell's employment by Consolidated he explained his invention upon two different occasions to individuals who were well qualified to and did fully understand said invention (R. 199-207).

The Court of Appeals apparently assumed, in reaching the conclusion it did, that Consolidated had been put to some cost or expense in connection with Garbell's invention, first in connection with the construction of models, and, secondly, in connection with Garbell's salary. Not one word of evidence was placed into the record by respondents as to cost of models. The only evidence in the record was introduced by petitioners herein, which entirely negatives any question of cost expenditure in connection with the Garbell invention or its making, developing or perfecting (R. 280-281, 454-5).

Garbell was under salary and his time was devoted to his employer. However, there is no evidence whatsoever of his spending his employer's time working on his own prior invention. It was fully conceived and devised when he entered Consolidated's employ, and is used in the accused device in its unchanged, original form.

It must be presumed that if the testimony introduced by petitioners herein was not in accordance with actual fact, respondents herein would have introduced evidence to the contrary upon the subject. As to most of the matters herein referred to, and to which Garbell testified, he was not even cross-examined by respondents.

It was not until on or about July 18, 1946, nine or ten months after terminating his employment with Consolidated, that Garbell learned that his former employer was using his invention in the manufacture of an airplane known as the Convair 240. On August 5, 1946 (R. 638), and on August 12, 1946 (R. 639), Garbell wrote Consolidated and took immediate steps to place his former employer upon notice (R. 217-218). Garbell did not sleep on his rights and he did not allow the user of the invention to proceed without notice and expend further sums in construction. The uncontradicted evidence is that respondents herein never advanced a claim of shop right or implied license until after Consolidated had been put upon notice, in August of 1946 (R. 236-7).

The Court of Appeals is likewise in error in taking the position that Garbell made a disclosure of this particular invention under the terms of the Invention Agreement.

Both petitioners and respondents herein introduced testimony that in December, 1944, Garbell was requested by his employer, Consolidated, to prepare a scientific paper for presentation to the Institute of Aeronautical Sciences, and that it was suggested to Garbell that he write about his wing (R. 289-90, 301). Such a paper was prepared and submitted to the Institute (R. 775). Garbell also placed a copy of said scientific paper in the hands of his employer, with a letter, in order to protect himself patent-wise, inasmuch as he realized that for the first time facts concerning his invention were being released to the

general public. As has been pointed out, Garbell had made many disclosures to Consolidated under the Invention Agreement and had followed the procedure outlined therein. Such procedure was not followed in the instance of the scientific paper, for he did not consider it or intend it to be a disclosure under the Invention Agreement. The paper was not sent to the Patent Department as required in the Invention Agreement.

Consolidated did not consider the receipt of the scientific paper as a patent disclosure, and nothing was done by it with reference thereto during the balance of the time that Garbell was employed, which was up to October 15, 1945. The records of Consolidated show that said paper was not received by its Patent Department until on or about January 24, 1946 (R. 354). No communication was ever sent to Garbell, although Consolidated had Garbell's then address (R. 363, 365). When Garbell wrote to Consolidated on August 5, 1946, in order to place said corporation upon notice that they were using his invention, for which an application for Letters Patent was then pending, Consolidated, in answering said letter, requested that a copy of the patent application be sent to it for the purpose of a disclosure, on the basis that in so doing the disclosure would be made to Consolidated without obligation (R. 641). Obviously, Consolidated was then, for the first time, asking for an official disclosure and was not making any claim of shop right or implied license.

JURISDICTION.

1. The jurisdiction of this Court to review the judgment of the Court of Appeals is based upon Title 28, United States Code, Section 1254(1).

2. This petition is timely filed. The judgment of the Court of Appeals was entered June 9, 1953 (R. 1148). Thereafter, and on July 8, 1953, petitioners duly filed a petition for rehearing with said Court of Appeals. Said petition was denied on July 13, 1953 (R. 1149). The application for a writ of certiorari may be made within ninety days thereafter (28 U.S.C.A. 2101(c)).

3. The jurisdiction of the Court of Appeals is based upon Title 28, United States Code, Sections 1291 and 1294. The jurisdiction of the District Court is based upon Title 28, United States Code, Section 1338(a).

QUESTIONS PRESENTED.

1. The trial Court in this case made special findings of fact based upon uncontradicted and unimpeached evidence. Was it error for the Court of Appeals to fail to give effect to such findings of fact?

2. The trial Court in this case made special findings of fact based upon the *only* evidence upon the subject matter of said findings. Was it error for the Court of Appeals to assume the existence of facts to the contrary, although not justified by the record, and thus fail to give effect to the special findings of the trial Court?

3. The affirmative defense of shop right or implied license was raised by defendants (respondents herein) in the trial Court. The uncontroverted evidence demonstrated the non-existence of those facts legally required to establish such defense. The trial Court specially found that such defense was not established. Was it error for the Court of Appeals to hold that such findings were "clearly erroneous"?

4. The Court of Appeals held that certain special findings of the trial Court pertaining to the defense of shop right and implied license were "clearly erroneous". Did the evidence support the holding of the Court of Appeals?

REASONS FOR ALLOWANCE OF WRIT.

The decision of the Court of Appeals in this case constitutes an abuse of discretion involving a matter of law, because:

Contrary to Rule 52(a) of the Federal Rules of Civil Procedure, 28 U.S.C.A., and the decisions of this Court, such as *United States v. United States Gypsum Company,* 333 U.S. 364, 394, 68 S.Ct. 525; *United, States v. Oregon State Medical Society,* 343 U.S. 326, 72 S.Ct. 690, said Court of Appeals held as being "clearly erroneous" certain special findings of the trial Court.

The special findings in question, pertaining to the failure of defendants (respondents herein) to establish their claims of shop right or implied or any

license were supported in one case by the entire evidence which was, on these particular points, uncontradicted. The record, even if considered in the light most favorable to respondents, unquestionably shows that the findings of the trial Court were supported not only by substantial evidence, but by a clear preponderance of all the evidence.

In *United States v. United States Gypsum Company, supra,* this Court held that if a reviewing Court, on the entire evidence, is left with the definite and firm conviction that a mistake has been committed, a finding is "clearly erroneous", although there is evidence to support it. This statement is obviously predicated upon the circumstance that there is evidence other than that which supports the finding. Thus, since in this case the only evidence supported the trial Court's findings, and there was no other evidence to consider, said findings were not "clearly erroneous".

As to the claim of shop right, unless the evidence reflects a full compliance with the terms of the Invention Agreement, hereinabove referred to, the claim must fail. The undisputed evidence in this case demonstrates that there never was a "disclosure" of the invention in question within the meaning and terms of said agreement, so that said agreement never became operative, hence respondents could obtain or have no rights thereunder.

This Court has repeatedly held that it is only in those cases where an employee has: (1) invented; (2) used his employer's time and materials to perfect,

develop or reduce to practise said invention; and (3) allowed his employer to use the invention without making any claim for compensation, that an implied license or shop right can arise.

Gill v. United States, 160 U.S. 426, 16 S.Ct. 322;

United States v. Dubilier Condenser Corp., 289 U.S. 178, 53 S.Ct. 554;

Solomons v. United States, 137 U.S. 342, 11 S.Ct. 88.

The undisputed record in this case demonstrates that not only did respondents herein fail to establish the existence of any of the elements of the so-called shop-right rule, but, on the contrary, petitioners herein conclusively established the nonexistence of those elements.

Inasmuch as the record, without conflict, clearly shows that the invention involved herein was not "made, developed or perfected" during Garbell's employment, there is no basis for the assumption to the contrary made by the Court of Appeals and stated in its opinion.

We submit, therefore, that the Court of Appeals exceeded its proper scope of review in rendering its decision hereinabove referred to, that said decision constitutes an abuse of discretion and, if allowed to stand, will result in a gross miscarriage of justice.

CONCLUSION.

For the foregoing reasons, it is respectfully submitted that this petition for a writ of certiorari to review the decision of the Court of Appeals for the Ninth Circuit should be granted.

Dated, San Francisco, California,
August 19, 1953.

THEODORE H. ROCHE,
Counsel for Petitioners.

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Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I.

OPINION OF THE COURTS BELOW.

The judgment of the United States District Court for the Southern District of California, Central Division, in favor of petitioners herein was entered January 15, 1951 (R. 58-65). The District Court's opin-

ion appears in the record (R. 37-57) and is reported at 94 Fed. Supp. 843.

The opinion of the Court of Appeals below appears in the record (R. 1140). The judgment of the Court of Appeals was entered June 9, 1953 (R. 1148). The petition for rehearing was duly filed with the Court of Appeals on July 8, 1953, which said petition was denied on July 13, 1953 (R. 1149).

II.

JURISDICTION.

The jurisdictional statement appears in the preceding petition for writ of certiorari (*supra*, p. 15).

III.

STATEMENT.

The essential facts are stated in the preceding petition for writ of certiorari (*supra*, pp. 2 to 14), and in the interests of brevity are not repeated here. Any necessary elaboration of the evidence will be made in the course of the argument which follows.

IV.

SPECIFICATION OF ERRORS.

1. The Court of Appeals erred in determining that the special findings of the trial Court, to the

effect that defendants (respondents herein) had not established the claim of shop right license nor established the defense of an implied or any license, were not supported by the evidence.

2. The Court of Appeals erred in holding, in effect, that the invention of Garbell was made, developed and perfected during Garbell's employment by Consolidated.

3. The Court of Appeals erred, as a matter of law, in holding that the findings of the trial Court as they pertained to the special defenses of shop right and implied license were "clearly erroneous".

4. The Court of Appeals erred in determining that the invention was disclosed by Garbell to his employer, Consolidated, under and within the terms of the Invention Agreement.

5. The Court of Appeals erred, as a matter of law, in holding that there was no evidence that Garbell reduced his alleged invention to practice prior to his employment by Consolidated.

V.

THE LEGAL ISSUES.

The legal issues are not complicated. The special defenses of shop right and implied license, in order to be availed of, require the party to an action relying thereon to establish the existence of certain elements and, in the absence thereof, the special defenses must fail.

Petitioners contend that the evidence introduced in this case fails in every respect to support the special defenses of shop right and implied license. Petitioners further contend that the entire evidence pertinent to said special defenses positively establishes the absence of any ground upon which such special defenses might successfully be based. The record establishes the fact that the findings of the trial Court were supported, not only by substantial evidence, but by all of the evidence in most instances and a great preponderance of the evidence in the remainder.

If the evidence establishes the fact that the invention of Garbell was not made, developed or perfected during the time that he was employed by Consolidated, the defenses of shop right and implied license must fail and the conclusions reached by the Court of Appeals are, hence, without foundation.

In addition to the ground just stated, the defense of shop right under the Invention Agreement must likewise fail, unless the evidence establishes that a disclosure was made of the invention by Garbell to his employer, Consolidated, under the Invention Agreement.

VI.

THE LAW.

The law applicable to the issues herein set forth is well established and not open to question.

1. A finding is not to be disregarded on appeal unless "clearly erroneous".

Rule 52(a), Federal Rules of Civil Procedure (28 U.S.C.A.) states:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

In the application of this rule, reviewing Courts have emphasized the importance of the conclusions of the trial judge which derive from his opportunity to pass upon the credibility of the witnesses; and they have declined to resolve a conflict on the testimony of witnesses their own way.

See:

Davis v. Schwartz, 155 U.S. 631, 15 S. Ct. 237;
Adamson v. Gilliland, 242 U.S. 350, 37 S. Ct. 169.

The case last referred to, and which has been frequently cited, contains this language:

> "* * * so far as the finding of the master or judge who saw the witnesses 'depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.' *Davis v. Schwartz,* 155 U.S. 631, 39 L. Ed. 289, 291."

Under the rule laid down in said *Adamson* case, certiorari has issued where the Court of Appeals has exceeded its proper scope of review by failing to give effect to the facts found by the District Court.

"1951 Ed. Robertson & Kirkham, Jurisdiction of the Supreme Court of the United States", by Wolfson & Kurland, p. 704, sec. 354, note 14, citing:

E. H. Ferree Co. v. United Shoe Machinery Corp., 290 U.S. 614, 54 S. Ct. 69.

The meaning of the phrase "clearly erroneous" has been defined by this Court in the case of

United States v. United States Gypsum Company, 333 U.S. 364, 394, 68 S. Ct. 525, 541,

where this language appears:

> "A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court on the entire evidence is left with a definite and firm conviction that a mistake has been committed."

See, also,

United States v. Oregon State Medical Society, 343 U.S. 326, 72 S. Ct. 690.

From said definition, it is readily apparent that, when the finding is supported by evidence, other evidence must exist which is in conflict therewith before such finding can be held to be "clearly erroneous".

2. A finding supported by uncontradicted testimony or all of the evidence on the subject cannot be "clearly erroneous".

It is axiomatic that uncontradicted testimony must be followed.

Chesapeake & Ohio Railway Co. v. Martin, 283 U.S. 209, 216, 217, 51 S. Ct. 453;

S. F. Association for Blind v. Industrial Aid for the Blind (C.C.A. 8), 152 Fed. (2d) 532, 536;

Foran v. Commissioner (C.C.A. 5), 165 Fed. (2d) 705;

Grace v. Commissioner (C.C.A. 9), 173 Fed. (2d) 170.

The only exception to the rule occurs when the Appellate Court is dealing with testimony given by witnesses who stand impeached and whose testimony is contradicted by the testimony of others or by physical or other facts actually proven or with testimony which is inherently improbable.

Grace Bros. v. Commissioner (C.C.A. 9), 173 Fed. (2d) 170, and cases therein cited.

3. The shop-right rule.

The authorities universally hold that in the case of employer and employee a shop right arises where the employee:

(a) Conceives or devises some process, method or instrument;

(b) Uses and causes to be used the property and other employees of his employer to develop, perfect or make and put into practicable form his invention;

(c) Assents to or acquiesces in the use of such invention by the employer.

Gill v. United States, 160 U.S. 426, 16 S. Ct. 322;

Solomons v. United States, 137 U.S. 342, 11 S. Ct. 88;

United States v. Dubilier Condenser Corp., 289 U.S. 178, 53 S. Ct. 554.

In discussing the shop-right rule, this Court said, in *Gill v. United States*, 160 U.S. 426, at page 430:

> "The principle is really an application or outgrowth of the law of estoppel *in pais*, by which a person looking on and assenting to that which he has power to prevent is held to be precluded ever afterwards from maintaining an action for damages."

4. Reduction to Practice Rule.

The Court of Appeals, in the opinion rendered by it, disagreed with the holding of the trial Court that Garbell made, developed and perfected his alleged invention when he devised and conceived it, saying:

> "An invention is not made, developed or perfected until reduced to practice." (R. 1146.)

There is no question that this is the law in cases of interference or infringement where the contest is between two persons, each claiming to be the inventor or the assignee thereof. However, it is not the law, and has no application, in a case such as the one now before the Court, wherein the defendants (respondents herein) are not seeking any title to or interest in the invention or patent, but have merely set up the defense of shop right or implied license.

See,

Heywood-Wakefield Co. v. Small (C.C.A. 1), 87 Fed. (2d) 716 (Cert. Den. 301 U.S. 698).

In that case, an employee, during the time he was employed, invented a reversible car seat. Upon showing a cardboard model to his employer, the employer ordered a full-scale seat to be made up. Subsequently, the inventor obtained a patent and brought an action against his former employer, which employer claimed possession of a shop right as one of its defenses to said action. Defendant contended, among other things, that an invention must be reduced to actual practice before it is complete as a patentable invention, and, therefore, the work of the defendant in proving that the plaintiff's idea was practical by building a full-sized model was essential to the completion of the invention, and cited a substantial number of authorities in support of said proposition. The Court, in holding the cited cases as not applicable, at page 719, said:

> "The cases cited * * * are all cases involving interference and priority."

After a discussion of one of said authorities, the Court, at page 720, states the correct rule:

> "Where, however, the inventor applies for and obtains a patent on his own draft and application, his invention, if patentable, is considered complete where no interference or prior right is claimed, especially if one skilled in the art can from his draft and description in the application make the device, as it apparently was done in this case, since the defendant made up and sold car seat bases built according to the plaintiff's so-called cardboard and 'cigar box model'."

VII.

THE EVIDENCE.

There but remains the examination of those pertinent portions of the record which will disclose upon their face whether or not the findings of the trial Court with relation to the questions of shop right and implied license are supported by the evidence so that it would constitute a reversible error to hold that said findings are "clearly erroneous".

In the belief that by so doing we may lessen the burden of this Court, we have quoted from the record itself, so that this Court will not find it necessary to refer to the record in every instance.

A. THE EVIDENCE AS TO SHOP RIGHT.

The evidence in this case discloses a factual situation which completely eliminates the shop-right theory and demonstrates the absolute failure of respondents to carry the burden, which was entirely theirs, of proving the affirmative defense of shop right.

1. The invention here involved was devised and conceived by Garbell prior to his employment by Consolidated.

This fact needs no discussion, as the trial Court so found and the Court of Appeals concurred (R. 1146).

2. There was no development or perfecting of said invention by Consolidated during Garbell's employment by it.

(a) The invention.

The character of this invention has heretofore been described (*supra*, pp. 4-5).

The undisputed fact is that no change, modification, development, correction or perfectioning was in fact made in the invention at any time after 1939, the date when it was conceived and devised.

(b) No development or change.

It is inconceivable that respondents herein would not have produced evidence of changes made or development of the invention, if any there were. The only testimony whatever on this subject was introduced by petitioners, such testimony standing alone, unchallenged, and uncontradicted. In testifying on this subject of improvement, Garbell said:

> "Q. Now, did any of these tests that have been referred to, these wind tunnel sections or these three-section wings, did they contribute in any way toward improvement or alterations in your invention or in perfecting it?
>
> A. No; no, absolutely not. If this is a criterion, there was no change from before to after. Even the first suggestion was complete, contained all the elements; nothing was modified.
>
> The Court. In other words, it is your contention that you added nothing to the conception or the practical carrying-out of the invention by anything that you did during the employment with the defendant?
>
> The Witness. That is right." (R. 461-462.)

Upon many occasions during his employment by Consolidated Garbell suggested or proposed the use of his invention in connection with some contemplated work. In testifying on this subject, Garbell gave evidence as follows:

"The Court. In other words, the conception preceded the work with this company, is that right?

The Witness (Garbell). Yes.

The Court. What you were doing here was not developed, but was merely suggesting that they adopt the conception?

The Witness. Yes.

The Court. A pre-existing conception.

The Witness. Yes. It was like stating—well, one person suggesting a flat roof for a building, and another one saying, 'Let's make it slope, so that the rain water will run off.'" (R. 280.)

And again:

"The Court. What you mean to say, however, is that these were not the working out of an idea, but merely putting the idea in writing and saying, 'That is my idea. Can you use it?'

The Witness. Yes." (R. 281.)

Not one word of testimony on this subject was put into the record by respondents, thus there is not even a conflict in the evidence. By reason thereof, we feel that the Court of Appeals was mistaken in believing that development or perfecting of the invention took place during Garbell's employment by Consolidated.

(c) Proposals v. Final Plans.

Throughout the record there is evidence of the fact that during his employment by Consolidated Garbell repeatedly proposed or suggested the use of a wing falling within the meaning of his invention. These "proposals" were at the initial stage on any given project and never reached the final design of the airplane or wing then under consideration during Garbell's employment. The testimony above set forth properly characterizes these proposals.

A mere suggestion, one among many, is of no importance whatsoever on a shop-right claim. If the idea had been incorporated in the final design for a certain airplane, from which the airplane was to be built, and the inventor knew of such incorporation, he certainly would have been placed upon notice. Such is not the case here.

In no single instance was Garbell's invention ever placed in final design during his employment and with his knowledge. There is no evidence that it was ever carried into final design while he was employed by Consolidated.

The Court of Appeals may very easily have been led into believing that Garbell aided in the preparation of final plans for one or more airplanes embodying his invention by reason of the unfortunate choice of words used by respondents' counsel in his cross-examination of Garbell. Repeatedly he kept using the phrase "plans or design for an airplane" (R. 243-254), when actually all he meant was preliminary reports or proposals.

The confusion was eliminated by action of the trial Court as follows:

"Mr. Frederick Lyon. Your Honor, please, I wonder why we can't have a definition of what he means by the words 'plans' and 'design'.

The Court. I understand what he means.

Mr. Frederick Lyon. The witness doesn't seem to.

The Court. He means preliminary work by way of discussion.

Mr. Gerlach. Yes." (R. 252.)

And again:

"Q. (By Mr. Gerlach). And did you participate in making the plans for that aircraft, so far as the airfoil is concerned?

Mr. Frederick Lyon. May we have a definition of what he means by the word 'plans'?

The Court. It is evident to the witness. Let us go on from there.

Mr. Frederick Lyon. May we ask the witness if the question is evident on that word?

The Court. He is answering. He understands it. Go ahead. It means any step that was taken. He doesn't mean blueprints.

The Witness (Garbell). A suggestion proposal.

The Court. A suggestion or proposal; yes." (R. 254.)

Respondents introduced several reports into evidence which contained proposals by Garbell for the use of his wing, such as defendants' Exhibit B (R. 694; 258-9). In referring to these reports, Garbell was asked whether it was a design for an airplane. This answer was given:

"A. No. It is a suggestion, of which usually there are at least two or three or four, and the plans of the airplane are eventually decided from any of this number of preliminary suggestions.

Q. As far as the work of proposing the use of your invention was concerned, what part of one of these so-called proposals is that?

A. That is the smallest part.

Q. Actually, it is just a suggestion of using three particular airfoils?

A. Yes.

Q. There is no mathematics, no computations or anything else required to make such a proposal, is there?

A. Very little. Well, usually I did them at home, because it was the only place where it was quiet.

Q. It is the same thing as if you proposed to the purchasing department that they buy one kind of an automobile over another kind, isn't it?

A. Yes." (R. 279-280.)

3. There was no reduction to practice of said invention by Consolidated during its employment of Garbell of which he had notice or knowledge.

In order to have brought themselves within the shop-right theory, it was encumbent upon respondents to have proven the construction of the invention (reduction to practice) with the knowledge and consent of the inventor and that such construction was made in order to perfect, develop or use the invention. It is not enough if such construction was for a demonstrational test only, made by the employer for his own information and knowledge, nor if such con-

struction did not fully and completely utilize the invention.

See *supra,* pp. 28-29, for analysis of

Heywood-Wakefield Co. v. Small (C.C.A. 1), 87 Fed. (2d) 716, 719 (cert. den. 301 U.S. 698),

and see, also:

Massie v. Fruit Growers Express Co., 31 Fed. (2d) 463, 466.

(a) Models involved.

The Court of Appeals in reaching the conclusion expressed in its opinion, obviously assumed that some of the models constructed and run through wind-tunnel tests constituted a reduction to practice. Such an assumption is not supported by the evidence.

At this point, an enumeration of the structures involved would be helpful.

In point of time, but three aircraft proposals can or do have any bearing on this case. They are, in the order of their appearance: (1) The two-engine tailless; (2) the XB-46; and (3) the Model 110.

Garbell left the employ of Consolidated on October 15, 1945.

The two-engine tailless never went past the model stage and was then abandoned, so models only are involved.

One airplane of the XB-46 type was built and flown, admittedly after 1946, long after Garbell's employment had terminated, so models only are involved.

One airplane of the Model 110 was built and flown subsequently to the XB-46, so for the same reason models only are concerned.

The accused airplane, Convair 240, did not come into the picture until after Garbell had left Consolidated, so no part is played by it in the shop-right theory.

(b) Model types.

The evidence in this case discloses that models were made for testing in a wind tunnel, such tests to be for diverse purposes; that some models were immovably fixed to a base for static observation only, hence called "static"; that some models were made so they could be actually flown in the wind tunnel and thus truly be "completely operating model"; that some were made to test wings and some were made to test appendages, such as nacelles, control systems, etc.

We submit that for a structure to fall within the shop-right theory, it must contain all of the elements of the invention and fully operate, so that the teachings of the invention can be demonstrated, otherwise there is no "use" made of the invention, and it is not reduced to "practicable form" within the meaning of the authorities. Therefore, only those free-flying, fully operating models can be considered, for, obviously, it is impossible to demonstrate and reduce to practice the invention by using a model limited in scope, such as a "static" model. Freedom of movement and the availability of operating controls are vitally necessary to demonstrate the RECOVERY of the aircraft from a

stall, which recovery is afforded by the Garbell wing. Such a model was never built by Consolidated.

(c) The two-engine tailless.

The testimony of Garbell for petitioners and Bayless for respondents is in full accord on this subject and without conflict. As such testimony pertains to models, it may be summarized as follows:

Three models were built.

The first was a static wind-tunnel model with a two-section wing. (Not Garbell's wing.)

The second was made for studies of the nacelles and fuselages, wing-tip fins and the extensible front and rear surfaces and flaps, all embraced within an invention by one Sutton, which invention Consolidated had acquired. This model had a three-section wing (Garbell's), which was used in order to get some variation from the first model, so that additional information on all the auxiliary controls and appurtenances could be obtained. (R. 454.) This was NOT an operating free-flying model.

The third model was a free-flight model, which was to be tested in the NACA free-flight wind tunnel. This had a two-section wing. (Not Garbell's wing.) (R. 256-7, 454-6, Garbell; R. 322-3, Bayless.)

From the foregoing two things are apparent and neither is any aid to the shop-right theory. First, no operating model of the invention was made. Second, Consolidated used the static model to test and develop its own ideas on control surfaces and other appur-

tenances only; no tests were made to experiment with the Garbell wing.

(d) The XB-46.

Although the defense of shop right is an affirmative defense and the burden is on the defendant to prove it, not upon the plaintiff to disprove it, respondents introduced no testimony concerning models made. The record shows nothing but an unqualified, bare statement by respondents' witness Bayless that Garbell made his usual suggestion and it was incorporated.

The real facts were placed in the record by the petitioners. Their testimony was in no way challenged. The only model made by Consolidated was a static wind-tunnel model which was made and used to test other things on the model but not its wing, which wing followed the Garbell suggestion. Following this model, Consolidated built a full-scale mock-up which incorporated a two-section wing. (Not Garbell's wing.)

The true situation is readily grasped from the following:

> "Q. Now you heard Mr. Bayless testify that there were wind tunnel models made for the XB-46. What did he tell you concerning the cost of these at the time they were made?
>
> A. It was exactly the same thing again. The company had available, or would have available within a matter of weeks, test data provided free by the Government through the National Advisory Committee of Aeronautics on 2-section wings of the type needed, and placing such a wing on the model would have been a duplication. The tests

that were contemplated were intended and actually came out to be primarily tests of air intakes, nacelle afterbodies, stability and control and control forces, that is, control effectiveness and control forces, and flaps and—well, the tests came out exactly that way.

On one occasion Mr. Bayless found it even necessary to go to the Massachusetts Institute of Technology to do the necessary development work, which is crude, it is in the wind tunnel, on flaps in order to provide adequate elevator effectiveness." (R. 458, Garbell.)

"Q. And did they ever build an XB-46 while you were employed by them?

A. No, the only thing they had was a full-sized mock-up, that is, one to determine spaces, etc., and the mock-up wing, I looked at it very closely in the experimental factory, had a 2-section wing." (R. 459, Garbell.)

On cross-examination, Garbell testified:

"Q. Now was an airplane built according to the plans or proposal of the XB-46?

A. Yes, an airplane was built but long after my leaving, and a mock-up was roughed out at a time when the management apparently planned to go ahead and that mock-up had a 2-section wing down the experimental hangar. And I was told, on as late as May 5, 1949, by Mr. Bayless, at 7:30 p.m. in the lobby of the Statler Hotel, while he was waiting for Hugh Freeman of the NACA, that at the time when I resigned and for a considerable time after that the management made it very clear that they would have no part in the production and building of that aircraft.

Mr. Gerlach. I move to strike the last part of the answer.

The Court. No.

The Witness. Because that was entirely in agreement with what I knew at that time.

Q. (by Mr. Gerlach). An airplane was built?

A. Yes.

Q. The XB-46?

A. Yes.

Q. From the proposal?

A. Yes.

The Court. Let us find out the time. When was it built?

The Witness. That I don't know, your Honor.

The Court. It wasn't built while you were there?

The Witness. No.

The Court. I gathered that from what you said.

A. A mock-up was built, which did not incorporate my work.

The Court. I see." (R. 255-6.)

Certainly this evidence is a far cry from the proof of use so sorely needed by respondents. In the light most favorable to respondents, the testimony of Bayless creates only a slight conflict, certainly not one which would empower the Court of Appeals to ignore the determination of the trial Court.

(e) The Model 110.

As in the case of the XB-46, respondents put in no testimony whatsoever on the Model 110 save and except the statement by their witness Bayless that

according to his recollection Garbell was still with Consolidated when early designs on the Model 110 were in progress. (R. 300.)

Garbell testified that he suggested the use of his wing for the Model 110 (R. 275; 467), and also:

"Q. Did you ever do any work on the Consolidated Vultee 110?

A. No work, no.

Q. Did you ever correct any mistakes that others might have done on that?

A. Yes, through suggestions. I understood that the effect of the propeller slipstream on the longitudinal stability was quite terrible, it was way beyond what the CAA could have possibly tolerated, and I suggested tilting the nacelles 5 degrees to reduce that effect.

Q. Was this on a model or on a full-sized plane?

A. No, on the model.

Q. Did you ever know until after your employment was over that they built a 110?

A. No.

Q. Did they tell you they were going to build one?

A. No.

Q. Did they lead you to believe that they were going to build one?

A. No, it was supposed to be a dead duck.

Q. They said that?

A. Yes." (R. 458-9.)

From the testimony adduced at the trial, it is apparent that, as far as the construction of models is concerned, we are confronted with nothing more than

incomplete demonstrational tests, which could not possibly affirm or disprove the claims of the invention, which were abandoned prior to Garbell's termination of employment and which could in no possible way be construed as reduction to practice.

(f) Garbell reduced invention to practice before employment.

There is still another point to be considered on the question of reduction of the invention to practice, the evidence of which stands alone and unchallenged.

It will be recalled that Garbell entered the employment of Consolidated on September 7, 1942. (R. 211.) Prior thereto, and during the summer of 1939, he met Dr. Robert C. Platt, then a leading aerodynamicist for the National Advisory Committee for Aeronautics, at Elmira, New York. At this meeting, Garbell described and explained the invention now set forth in the Garbell patent to Dr. Platt, including all essential elements of the patent in suit. Dr. Platt fully understood both the principle of operation and the structure invented by Garbell. This meeting of Garbell with Dr. Platt was followed by correspondence passing between Garbell and one Dr. George Lewis, then Director of the Aeronautical Research of the NACA. (R. 199-202.)

In October of 1939, Garbell became employed as an instructor at the Boeing School of Aeronautics, Oakland, California. While there, he met and became acquainted with an aeronautical engineer by the name of Harry Bradford Chin, who was then instructing in aircraft design at the Boeing School. Some time in the

Fall of 1940, during one or more discussions, Garbell thoroughly described his invention to Chin and made drawings and sketches to explain and illustrate his invention to Chin. Both the principle of operation and the structure invented by Garbell were fully understood and appreciated by Chin. (R. 202-207.)

It is the contention of petitioners that the invention here involved belongs to that category of inventions complete in and of themselves, and that it only takes the explanation thereof to anyone skilled in the art to enable the invention to be reduced to practice. This, of course, is the so-called constructive reduction to practice, but the courts, in certain instances, have upheld the theory of constructive reduction to practice over a physical reduction to practice. We believe that this is one of those instances.

As was said in the case of

Curtiss Aeroplane & Motor Corp. v. Janin (C.C.A. 2), 278 Fed. 454, 456:

> "Reduction to practice is not merely a matter of construction, building and trial, but may consist in a disclosure of the idea by any kind of description, pictorial, verbal, or written, which will enable one skilled in the art to make and use that which is disclosed. We think a drawing may possibly be a sufficient reduction to practice and an experimental machine insufficient for the question is one of degree, and the ultimate test is always whether the inventor has shown operative means to that theoretical omnipresent person, the man skilled in the art."

Admittedly, if respondents were making some claim to the invention or we were involved with an interference proceeding under the patent laws, the constructive reduction to practice by statements and drawings would not be sufficient to protect the inventor. However, as against the defense of shop right, it is entirely sound in principle.

Furthermore, the evidence above referred to, standing alone and uncontradicted, gives concrete support to the finding of the trial Court, and which finding the Court of Appeals declares to be clearly erroneous, that the reduction to practice of Garbell's invention took place prior to his employment by Consolidated.

4. The employer's cost question.

As part of the shop-right theory, and in keeping with the equitable principle that one should not gain at the expense of another, the employer must prove that he was put to cost and expense, his employees were used, and he furnished materials, all in the construction of the employee's invention, which he would not otherwise have done. The Court of Appeals has assumed such a situation in this case, but it is an assumption without foundation.

The simple fact is that the respondents failed to place into the record any evidence whatsoever on the question of costs, even though the defense of shop right is an affirmative defense and the burden was upon them to prove every component element of that special defense.

We have demonstrated hereinabove, from an analysis of the evidence, that the models made by Consolidated were so made for its own express purposes and by its own direction, upon its own idea, and to test and evaluate its own nacelles, control surfaces and other appurtenances, but not the Garbell wing. Under such circumstances, no additional cost was incurred by Consolidated. Obviously, some wing had to be placed on the model to serve as a test platform for these other component parts. No operating, free-flying model of the Garbell wing, with its attendant cost, was ever made.

The complete absence of any evidence or proof of costs expended by the defendants creates a fatal weakness in a defense predicated upon the shop-right theory.

True, Garbell was under salary and his time was devoted to his employer. There is no evidence of his spending his employer's time working on his own prior invention. It was fully conceived and devised when he entered Consolidated's employ, and is used in the accused device in its unchanged, original form. As has been pointed out, all that was necessary to construct a wing according to the invention was to specify three airfoils by camber and thickness ratio. Even this small matter was, according to the uncontradicted evidence, worked out by Garbell at home and not on company time. (R. 279-280.)

During the trial, reference was made to reports upon which Garbell worked, which gave the results of

wind tunnel tests of various models, obviously for the purpose of seeking or attempting to create the impression that cost and expense were incurred by the company, although there is no mention of a five-cent piece in the entire record. From the analysis of the evidence already given in this brief, it is self-evident that the necessity for the tests and the reports was not the Garbell invention, but the multitudinous tests that Consolidated found necessary to make concerning other items connected with the planes in question, such as flaps, control system, nacelles, etc., etc.

Strangely enough, and as in other instances already pointed out, the only evidence on this question was introduced by petitioners. Garbell testified as follows:

> "Q. (Mr. Frederick Lyon): Did you ever work out the details of how to make a wing of this kind and present the details to Consolidated, in detail, at their expense?
>
> A. No." (R. 280-281.)

Using the second static model of the two-engine tailless as an example, Garbell testified as to the method of construction of a two-section wing and his three-section wing, stating:

> "Q. What kind of wing did that model have?
>
> A. That was the wing, according to my suggestion—I mean, well, I was told that merely to repeat the other wing would have been a duplication. The old model had dried out in the wind tunnel, as they usually do, and started cracking.
>
> Inasmuch as these additional tests were designed to obtain information on all of the appur-

tenances and control devices there was no cost incurred, and, therefore, it was all right to include my suggestion.

Incidentally, I might mention, that just because my suggestion includes three sections—the other one, two—that still doesn't make any difference in labor, because it is impossible to build a model, even a two-section model, simply by cutting out two sections and then letting the milling machine run between the two, because the block of wood bends. It is necessary, therefore, to make 5 and 7 and 9 intermediate sections, even though following a straight-line fairing, and then do the hand work between the sections. Regardless of how many aerodynamic control sections there are, the work is still the same, even on a so-called two-section wing." (R. 454-5.)

If this testimony had been not in accordance with actual fact, respondents would have introduced evidence upon the subject. Garbell was not even cross-examined on his statements, hence they stand as established fact in this case.

5. Inventor did not assent to or acquiesce in use of invention by employer.

The one remaining question under the shop-right theory is this: What did the inventor do when he first learned his former employer was using the invention?

The evidence discloses the fact that Garbell terminated his employment with Consolidated in October 1945. Thereafter, about July 18, 1946, he learned that Consolidated was then manufacturing and building its

Convair 240, which is the accused device involved herein.

On August 5, 1946, and on August 12, 1946, Garbell addressed communications to Consolidated and advised that company that it was using the subject-matter of an invention upon which a patent application was then pending. (R. 218; Pltffs. Exh. 17, R. 638.)

The inventor and former employee took immediate steps to place his former employer upon notice once he had learned of the fact that the former employer was for the first time using his invention. There was no sleeping on his rights, and he did not allow the user to go on without notice and expend further sums in construction.

Thus, in this instance, as in all the others, we find the complete failure of operation of the shop-right theory.

The attention of this Court is also directed to the fact that no claim of shop right was ever advanced, intimated or made by Consolidated from the date of Garbell's employment in September 1942 until an exchange of correspondence between Consolidated and Garbell subsequent to Garbell's placing Consolidated upon notice in August of 1946.

The testimony on this subject is very clear and the respondents have not contended otherwise. (R. 236-237.)

B. THE EVIDENCE ON THE INVENTION AGREEMENT AS IT PERTAINS TO SHOP RIGHT.

In the forepart of the decision as rendered by the Court of Appeals, particular attention is paid to the Invention Agreement executed on or about September 7, 1942, by Garbell and Consolidated. In analyzing the agreement and the evidence pertaining thereto, the Court of Appeals concurred in the opinion of the trial Court that Consolidated had taken no steps, as provided for in the Invention Agreement, toward acquiring the invention here involved, and, therefore, had waived whatever right Consolidated may have had to acquire Garbell's invention or the patent issued thereon. (R. 1143.)

The effect, however, of the Court of Appeals' decision is that Consolidated acquired a shop right under said agreement by reason of the terms thereof, and particularly those provisions referred to in paragraph 6 of said agreement. Such a conclusion can only be predicated upon the assumption that a disclosure of Garbell's invention was made to Consolidated under said Invention Agreement. The Court of Appeals is in error in making such an assumption, as the evidence discloses:

(1) that the Invention Agreement did not operate upon or in any way affect the invention involved herein; and

(2) that no disclosure was made by Garbell to Consolidated of said invention under the terms and provisions of said Invention Agreement.

These two points will now be discussed in the order in which they are above referred to:

1. The Invention Agreement did not operate upon or in any way affect the invention involved herein.

The crux of the agreement lies in subparagraph (a) of paragraph 1, where a limitation is placed upon the operation of the agreement. The pertinent language is to the effect that the employee agrees "to disclose promptly in writing * * * all inventions * * * made, developed, perfected, devised, and conceived by the employee * * * during the employee's employment by the Company." (Pltffs. Exh. 16, R. 633; R. 215.)

Inasmuch as the trial Court and the Court of Appeals have determined that the invention was *devised and conceived* by Garbell prior to employment, the agreement can then only operate in this particular case on an invention *made, developed or perfected* during employment. It has already been demonstrated (*supra,* pp. 31-45) that the uncontradicted evidence is that said invention was not made, developed or perfected by Consolidated nor was there a reduction to practice of said invention by Consolidated during its employment of Garbell of which he had notice or knowledge.

It is apparent then, that inasmuch as Garbell's invention was *not made, developed, perfected, devised or conceived* by Garbell, either solely or in collaboration with others, *during* Garbell's *employment* by Consolidated, the Invention Agreement cannot have any effect whatsoever upon this particular invention.

Under such circumstances, it is absolutely impossible for Consolidated to have acquired a shop right, or any other right.

2. No disclosure was made by Garbell to Consolidated of said invention under the terms and provisions of said Invention Agreement.

(a) Garbell's knowledge of patent procedure of Consolidated.

The record in this case shows that Consolidated maintained at all times during Garbell's employment a Patent Department, and had a well-established system set up whereby ideas and inventions made or conceived by an employee could be submitted to the company under the Invention Agreements previously signed by each employee. The procedure adopted by the company and followed by it is completely outlined in the testimony of respondents' witness Walter J. Jason, Assistant Patent Director of Consolidated (R. 351, et seq.). From such testimony, and from the Invention Agreement itself, the consecutive steps taken were as follows:

(a) A written disclosure made by the employee to the Patent Department;

(b) Within a period from one to four weeks thereafter, the employee would receive a written notice advising him of receipt of the disclosure, the docket number assigned to it, and that he would be advised of the results of the company's investigation;

(c) If the company, after investigation, considered any invention patentable, the inventor was paid the sum of $10.00;

(d) If the company elected to acquire the invention, written notice of that fact was sent to the inventor;

(e) Thereafter the employee would be requested to execute two forms:

1-80-39 "Notice of Election to Acquire Invention"

1-80-42 "Assignment of Invention"

(f) As an alternate step, should the company believe the invention to be unpatentable, or should it elect not to acquire it, written notice was sent to the inventor, telling him of that fact and stating that the case was being placed in the inactive file of the company; in addition, the inventor was advised that he could have a release if he so desires.

Within not too long a period after his employment, Garbell, at the suggestion of Bayless, his superior, went to see Donald Hall, who was then in charge of the Patent Department of Consolidated. Hall explained to Garbell the functions of the Patent Department and how it operated, especially with reference to the Invention Agreement (R. 447-448).

Thus, Garbell obtained full knowledge of the operation of the Patent Department and the Invention Agreement, the method involved in submitting a disclosure under the Invention Agreement, and what was expected of him and what he could expect from the company.

(b) Disclosures made by Garbell to Patent Department.

Between March 29, 1943, and April 30, 1945, in accordance with the said Invention Agreement, Garbell formally submitted to Consolidated seven disclosures, which covered the following alleged inventions:

1. Slotted Armor Plate.
2. Retractable Tail Surface.
3. Hydrofoil for Airplanes.
4. Wing Tip Fin.
5. High-speed Air Intake.
6. Dropable Jet Augmenter.
7. Longitudinal Control for Jet Aircraft.

All of these disclosures were duly docketed by Consolidated and duly given numbers within a short time after their submission (R. 353). Thereafter, the procedure as outlined in the Invention Agreement was followed and the successive steps taken by Consolidated. The situation is characterized by the following testimony of Garbell:

> "Q. Whenever you made a disclosure to the corporation in writing other than with reference to this invention before this court, were you immediately paid by Consolidated for that suggestion?
>
> A. The immediate step was to follow a certain procedure, that is, regarding inventions that did fall under the Invention Agreement, followed by the payment provided for in the Invention Agreement.
>
> Q. And you were always paid on these suggestions?

A. On most of them, of those that were given consideration, yes, and the payment was prompt." (R. 283.)

The testimony discloses that of the seven disclosures made by Garbell to Consolidated two of them were accepted by the company. These were the hydrofoil for airplanes and the high-speed air intake. Thereafter, the various payments called for by the Invention Agreement were made, and eventually Garbell executed the assignments, etc., as called for by the agreement. In the case of the disclosure for an alleged invention for slotted armor plate, Consolidated did not accept the invention, notified Garbell to that effect, and duly executed a release under date of February 24, 1944. (R. 316-322.)

There is no question but that Garbell, on the one hand, and Consolidated, on the other, knew what was expected of each under the terms of the Invention Agreement, and the procedure which was to be followed, had been followed, and would be followed.

(c) The alleged disclosure of the invention in suit.

In December 1944, Garbell prepared a scientific paper for presentation to the Institute of Aeronautical Sciences. Such paper was prepared upon the request of his superiors, T. P. Hall and Bayless, under direction that the subject-matter was to be on some scientific matter, but eliminating anything of military significance and likewise eliminating anything that would tend to disclose actual company activities. (R. 289-290, Garbell; R. 301, Bayless.)

In the conversation which T. P. Hall had with Garbell, he suggested that Garbell write about his wing. (R. 290.)

The document in question, as prepared by Garbell and sent by Consolidated to the Institute of Aeronautical Sciences as a technical paper, was introduced in evidence by appellants, as their Exhibit D, during their cross-examination of Garbell. In characterizing the paper so prepared by him, Garbell testified:

> "Q. (By Mr. Gerlach). Does Exhibit D contain a description and illustrations exemplifying your patent in suit?
>
> A. It contains a very broad scientific explanation of the basic principles.
>
> Q. It contains descriptions and it contains drawings which, to some extent, follow the drawings of your patent, do they not?
>
> A. Broadly speaking, yes." (R. 269, Defts. Exh. D; R. 775.)

If this Court will take but a moment to glance at Plaintiffs' Exhibits 26 (R. 669-676; R. 320) and 27 (R. 677-683; R. 322), it will immediately observe that there is absolutely no similarity between actual disclosures to the Patent Department of Consolidated and the scientific paper (Defendants' Exhibit D, R. 775; R. 269). It is not, nor was it intended to be, a "disclosure" within the terms of the Invention Agreement.

(d) Neither Garbell nor Consolidated considered the paper to be a "disclosure" under the Invention Agreement.

In seeking the proper interpretation to be placed upon a contract, agreement, or state of facts, the

Courts have long looked toward the actions of the parties themselves with regard thereto, in order to give a practical construction to the matter upon which the Court has to reach a decision. Such procedure applied to this case gives abundant proof that neither Garbell nor Consolidated ever believed that the scientific paper prepared by Garbell at Consolidated's request was a disclosure of an invention under the Invention Agreement.

As to Garbell.

This Court will readily appreciate that, by reason of his talks with Consolidated's Patent Department representatives and the many occasions during his employment Garbell submitted disclosures to Consolidated specifically acting under the Invention Agreement, he was thoroughly and completely familiar with what was required of him by way of form of submission of an idea, drawing, etc., and that he was required to be as specific as possible with relation to every phase of any such disclosure. Likewise, Garbell was thoroughly familiar with the steps, preliminary or otherwise, which Consolidated took with reference to a disclosure made to it under the Invention Agreement by an employee; and that this would result in patent studies, search of prior art, and conferences with Consolidated's Patent Department.

In this particular instance, he was requested by his employer to prepare a scientific paper, to be a contribution on Consolidated's behalf to the annual meeting of the Institute of Aeronautical Sciences. Pursuant to his instructions not to use anything of

a military nature or write about a subject which was involved with or as a company project, and following the suggestion of his superior that he write about his (Garbell's) wing, the paper in question was prepared in December of 1944.

While Garbell knew that this was not a paper prepared for a disclosure of an invention, he did realize that for the first time he was releasing for presentation to the public enough material and data concerning his invention, all of which might easily and detrimentally affect any application for a patent which he might thereafter make.

Having in mind that during the two preceding years of employment he had become thoroughly familiar with the dangers of public release of patentable ideas, Garbell knew that he should take some steps to protect himself. Therefore, with the sole purpose in mind of protecting his patent rights, he transmitted a copy of the paper, as prepared, to D. A. Hall, a patent engineer of Consolidated, accompanying the same with an interoffice memorandum in which he stated that he was making an official disclosure (patentwise) of invention. Considering the circumstances which then existed, and the conditions under which the paper was prepared, the language of his memorandum to Hall would, to Garbell's mind, act as a red flag to Consolidated and direct their attention to the fact that he had exclusive property rights in the invention described in the paper.

Nothing further was done by Garbell, nor was there anything required of him to be done. He had protected his rights in an invention which he had

at all times possessed long before entering his employment with Consolidated.

As to Consolidated.

First of all, there is, of course, the fact that Consolidated requested the preparation of the paper, not as an invention disclosure and not with that thought in mind, but so that the company would have a paper presented on its behalf at the next meeeting of the Institute of Aeronautical Sciences. It is apparent that, with T. P. Hall's suggestion to Garbell that the article be written concerning Garbell's wing, Consolidated knew that the wing was not a company project nor involved as such.

A copy of the paper, with its memorandum of transmittal, which, in effect, put Consolidated upon notice, was received by D. A. Hall, a patent engineer of Consolidated. Thereafter not one step under the Invention Agreement was taken by Consolidated. We have listed the procedure to be followed under the Invention Agreement (*supra,* p. 52), and that procedure was followed in all cases, not only with relation to all ideas which Garbell had submitted under that agreement, but it was the regular, usual and adopted practice that was followed in every case, according to the testimony of Consolidated's patent attorney, Jason. (R. 351-359.)

Garbell's written memorandum to Consolidated transmitting the copy of the paper in question bears date December 9, 1944. Under the Invention Agreement, a docket number is given a submission of invention by an employee, and he is advised thereof by

letter within thirty days after the submission of the idea. The records of Consolidated show that it assigned a docket number to the scientific paper on or about January 24, 1946 (R. 354, Jason), which is over a year after it had received the paper and months after Garbell had terminated his employment with Consolidated.

Consolidated, between December 20, 1944 and January 24, 1946, had, obviously, taken no steps concerning this matter. Once the docket number was given this paper, nothing further was done except to mark it "Inactivated". Not a communication was sent to Garbell. Garbell had not appeared at the Patent Department. (R. 360.)

Mr. Jason, Consolidated's assistant patent director, testified that "no report of any kind was ever sent to Dr. Garbell either of the submission of that idea to the Patent Department or to advise him that the Patent Department was processing that matter". (R. 363.)

To further highlight this matter, the record discloses that on March 26, 1947, and April 7, 1947, the Patent Department of Consolidated wrote Garbell, at his then address, advising him that the company was inactivating Garbell's disclosure of high-speed air intake, made on November 17, 1944. (R. 365; Plaintiffs' Exhibits 31 and 32, R. 692, 693.)

Consolidated did not advance any claim of shop right or license at the time that it received the scientific paper, which it now contends is a disclosure under the Invention Agreement, nor did it advance such a claim at any time until after Garbell had

advised it that it was using his invention, in the fall of 1946.

On August 5, 1946, Garbell wrote to Consolidated concerning the use by them of his invention and notifying Consolidated that application for letters patent was pending. (R. 638, Plaintiffs' Exhibit 17; R. 218.) On August 9, 1946, Consolidated answered said letter, stating, in part, as follows:

> "We will accept a copy of the patent application to which you refer for the purpose of a disclosure, on the basis that in so doing the disclosure is made to us without obligation * * *" (R. 641, Plaintiffs' Exhibit 18; R. 219.)

It is perfectly apparent that Consolidated was asking for the first time for an official disclosure and was not making any claim of shop right.

In answer to Consolidated's letter, Garbell, on August 12, 1946, wrote Consolidated and referred them to his paper appearing in the February 1946 issue of the Journal of the Aeronautical Sciences, as a document which stated the basic principles underlying his invention. (R. 639, Plaintiffs' Exhibit 17; R. 218.) It is to be noted that this was the publication of the scientific paper prepared for that purpose by Garbell in December 1944, while with Consolidated.

Following receipt of Garbell's letter under date of August 12, 1946, and just referred to, Consolidated, for the first time, took the position that the scientific paper written in December 1944 constituted a disclosure of invention under the terms of the Invention Agreement and that it had a shop right.

Just before Garbell left the employ of Consolidated, in October 1945, he had a conversation with D. A. Hall above referred to, who was the patent engineer to whom Garbell had sent the copy of the scientific paper nine or ten months before. During that conversation, no mention was made to Garbell of the matter now before the Court, and no shop right or other right was even intimated. (R. 449.)

One last fact concerning the acts of Consolidated is called to the attention of the Court, as it sums up the entire matter. Under direct examination, Garbell testified:

"Q. At any time did they inform you that they intended to use this invention of yours?

A. No.

Q. They never led you into the opinion they intended to use it?

A. No.

Q. Did they completely reject this invention at all times?

A. Yes, in each case.

The Court. During any of those conversations, was anything ever said to you regarding shop rights, regardless of the merit, such as, 'If it is any good, it is ours, anyway'?

The Witness. No.

The Court. Was any such claim made during these conversations?

The Witness. No.

The Court. When did you hear for the first time that shop rights were being claimed?

The Witness. After I directed my correspondence to the company, immediately following application.

The Court. Filing of your application." (R. 236-237.)

From all of the evidence, which is uncontradicted, it must be obvious to this Court that the principals in this matter did not ever consider or look upon the scientific paper in question as a disclosure under the Invention Agreement. This is amply demonstrated by their actions, as hereinabove reported.

VIII.

CONCLUSION.

We believe that a consideration of the evidence as pointed out in this brief will result in this Court's concluding that none of the elements necessary to establish the defenses of shop right or implied license exist, and that the findings of the trial Court on said issues were and are more than amply supported by said evidence.

It is respectfully submitted that the petition for certiorari to review the decision of the Court of Appeals for the Ninth Circuit should be granted.

Dated, San Francisco, California,
August 24, 1953.

THEODORE H. ROCHE,
Counsel for Petitioners.

THEO. J. ROCHE,
SULLIVAN, ROCHE, JOHNSON & FARRAHER,
Of Counsel.

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IN THE

Supreme Court of the United States

October Term 1953
No. 301

MAURICE A. GARBELL, INC., a corporation, and GARBELL RESEARCH FOUNDATION, a corporation,

Petitioners,

vs.

CONSOLIDATED VULTEE AIRCRAFT CORPORATION, a corporation, and AMERICAN AIRLINES, INC., a corporation,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

To the Supreme Court of the United States:

A. Opinions Below.

The opinion of the Trial Court appears at R. 37 and is reported at 94 Fed. Supp. 843. The opinion of the Court of Appeals for the Ninth Circuit appears at R. 1139 and is reported at ..... F. 2d ....., 98 U. S. P. Q. 4. A Petition for Rehearing was filed in the Court of Appeals by petitioners on July 7, 1953, and the same was denied by the Court of Appeals on July 13, 1953 [R. 1149].

B. Statement of Jurisdiction.

Petitioner invokes the jurisdiction of this Court under Title 28, U. S. C. A., Section 1254(1).

C. Counterstatement of the Case.

This is a patent infringement action, the District Court having entered judgment [R. 58] sustaining the validity and infringement of the patent in suit. The Court of Appeals reversed such judgment, holding that defendants have a license (*i. e.*, shop-right) under the patent in suit, and expressly made no decision as to either validity or infringement of the patent in suit [R. 1148].

The Petition (p. 4) concedes that the question involved concerns only an interpretation of the facts, stating:

> "To resolve the question involved, turning as it does entirely upon fact. . . ."

The only reason set forth in the Petition (pp. 16-18) for its allowance is that the Court of Appeals allegedly abused its discretion by not accepting the Findings of Fact of the District Court.

The Petition does not even allege that "there are any special and important reasons" in its support, as required by Rule 38(5) of this Court, and in particular:

(a) The Petition does not allege that any federal question is here involved;

(b) The Petition does not allege that the decision of the Court of Appeals is in conflict with that of any other court of appeals on the same matter;

(c) The Petition does not allege that any question of local law is here involved;

(d) The Petition does not allege that the Court of Appeals in its decision has so far departed from any

accepted or usual course of judicial proceedings as to call for any exercise of the power of supervision of this Court; and

(e) The Petition does not allege that any public question is here involved.

The Petition, in effect, merely complains that the Court of Appeals, after a review of the record in this case, came to a different interpretation of the facts than that of the District Court.

There is no reason, so far as the *public interest* is concerned, supporting the granting of the Petition. On the contrary, the public interest requires a denial of the Petition. Over 170 "Convair" airplanes have been sold by respondent Consolidated [R. 418] and are in extensive commercial airline service operated by respondent American Airlines and other airlines providing travel service to the public. To grant the Petition would simply be a step towards sustaining the patent in suit and, by injunction, grounding and forcing out of service such "Convair" airplanes, to the great injury and inconvenience of the public.

Since the Petition and Petitioner's Brief are largely devoted to an exposition of alleged facts pertinent to the issues here involved, and since the statements of fact therein are largely misleading and in many instances erroneous, a restatement of the significant facts is in order and is presented in the following section.

The Relevant Facts.

Letters Patent No. 2,441,758 in suit [R. 605], issued to the patentee Garbell, covers an airplane wing construction, sometimes hereinafter referred to as the "alleged invention in suit."

Garbell, the patentee of the patent in suit, was employed by respondent Consolidated on September 7, 1942, and terminated his employment on October 15, 1945 (Pet. pp. 6, 14). The application for Letters Patent No. 2,441,758 was filed on July 16, 1946, less than one year after Garbell terminated his employment with Consolidated.

The District Court found, in effect, that Garbell had "conceived" (as distinguished from "reduced to practice") the alleged invention in suit prior to his employment by Consolidated, but, as pointed out by the Court of Appeals [R. 1146], the only evidence supporting such finding was the testimony of Garbell himself. In the record there is no corroboration of any kind of Garbell's testimony that he had conceived the alleged invention in suit prior to his employment by Consolidated.

Garbell testified that shortly after his employment by Consolidated he disclosed his alleged invention to his superior in the company, Mr. Bayless [R. 446]. This was denied by Bayless who testified [R. 303] that the earliest that he knew of the invention was when Garbell and his co-workers Rogers and Fiul presented to Bayless a written report, Exhibit A [R. 1007], which is dated February 25, 1944, relating to the "Two-Engine Tailless" design, an airplane then being designed by Consolidated.

Garbell admitted that he suggested to Consolidated that it use his alleged invention in its "Two-Engine Tailless Design" [R. 250], and admitted that Exhibit A [R. 1007] embodies the principles of his invention [R. 247]. Exhibit A shows on its face [R. 1007] that it was a report and suggestion jointly made to Consolidated by Fiul, Garbell and Rogers (all employees). Exhibit A covers sixty-three pages of the record [R. 1007-1070], and includes extensive engineering calculations relating to the use of

the alleged invention in suit in the Consolidated "Two-Engine Tailless" airplane. Exhibit A shows on its face at R. 1007 that it was "approved by Consolidated." Bayless testified that such suggestion by Garbell was approved by Consolidated and incorporated in its "Two-Engine Tailless" design [R. 324]. Petitioners' Brief (pp. 36, 38, 39) concedes in effect that the "Two-Engine Tailless" was one of the Consolidated airplane designs for which Garbell suggested his alleged invention.

Petitioners' Brief (p. 38) concedes that "three models were built" by Consolidated of the "Two-Engine Tailless," the second of which, at least, included the alleged invention in suit.

Exhibit B [R. 694-774] contains many inter-company reports signed by Garbell and other Consolidated employees showing the extensive work done by Consolidated with models using the alleged invention in suit in the "Two-Engine Tailless," and showing his full knowledge of and participation in the same. Representative reports are detailed as follows:

(a) A "scale power-off model" of the "Two-Engine Tailless" was tested in the Galcit 10-foot wind tunnel from Feb. 28, 1944 to Mar. 5, 1944, which showed that the "revised wing" (*i. e.*, the alleged invention in suit) was satisfactory, but suggesting specific structural modifications [R. 694-696]. Such test demonstrated the improved stall performance of the new revised wing incorporating Garbell's alleged invention [R. 695], the improved results being set forth in detail [R. 698-702].

(b) A "power-on model" of the "Two-Engine Tailless" was actually in the Galcit wind tunnel on March 7, 1944 [R. 696].

(c) Additional "power-off" tests of the "Two-Engine Tailless" airplane were conducted from March 28, 1944, to April 7, 1944, at Massachusetts Institute of Technology with a wing that had been modified with respect to that tested at Galcit [R. 705].

(d) Free-flight tests of a model of the "Two-Engine Tailless" airplane were made prior to July 1, 1944, showing collaboration by Rogers of Consolidated [R. 725].

(e) Additional wind tunnel tests of the scale model of the "Two-Engine Tailless" using a modification of the "revised wing" (which included the alleged invention in suit) were made at Galcit in late July, 1944 [R. 735].

(f) Additional wind tunnel tests of a scale model of the "Two-Engine Tailless" were made by Consolidated prior to August 6, 1944 [R. 745].

(g) The "power-off" models of the "Two-Engine Tailless" each required about 3500 man-hours in their manufacture [R. 755-757].

(h) As late as December, 1944, Garbell was still trying to increase flying stability of the "Two-Engine Tailless" [R. 758-759].

The foregoing test reports on the "Two-Engine Tailless" airplane models plainly indicate the many changes and modifications that were made in the models during such tests [petitioners' allegation (p. 10), that no changes were made, to the contrary notwithstanding].

The extensive testing by Consolidated of at least one model of the "Two-Engine Tailless" including the alleged invention in suit while Garbell was employed by Consoli-

dated was confirmed by Garbell who testified that "there were hundreds and hundreds of runs that went into that" [R. 454].

The Garbell patent No. 2,441,758 in suit states [R. 605, Col. 10, lines 50-64]:

> "Numerous flight tests and wind-tunnel tests in reputable wind-tunnels such as the California Institute of Technology, the Massachusetts Institute of Technology, the various wind tunnels of the National Advisory Committee for Aeronautics, and elsewhere *have demonstrated convincingly that each of the objects of this invention has been fully achieved.* The tests were performed on numerous wing models, on sailplanes, and on models of at least five aircraft designs of widely varying design scope employing a wide variety of airfoil series. Force-test records, photographic records, and cinematographic records of the tests substantiate the attainment of the objects of this invention" (emphasis added).

Garbell identified such wind-tunnel tests referred to in his patent as those performed by Consolidated with models of the Consolidated "Two-Engine Tailless" and XB-46 airplanes in the wind tunnels at the California Institute of Technology, the Massachusetts Institute of Technology, and the National Advisory Committee for Aeronautics, including his alleged invention [R. 260-262]. Such tests made by Consolidated of the alleged invention obviously constituted a reduction to practice thereof, as they "demonstrated convincingly that each of the objects of this invention has been fully achieved" as stated in the patent in suit.

Garbell stated that prior to his employment by Consolidated no one had ever designed an airplane wing em-

bodying his alleged invention, and that even up to the date of the trial in the District Court neither Garbell nor anyone acting for him had ever manufactured such a wing [R. 238-239]. The Garbell patent in suit has had no public acquiescence or any commercial success whatever.

Garbell admitted that he suggested that Consolidated use his alleged invention in suit in a military bomber, the XB-46, being designed by Consolidated while he was employed by Consolidated and that they ultimately did so after he left its employ [R. 252-255, 262]. Petitioners' Brief (p. 36), in effect, admits the same thing. Extensive conferences were had in May, 1945, with respect to wind tunnel testing of the XB-46 design, between Consolidated (represented by Garbell and a co-employee Shue) and National Advisory Committee for Aeronautics representatives, in which many weeks of tests of a variety of models made by Consolidated were planned [R. 760-774], obviously with Garbell's full knowledge and consent. Garbell admitted that Consolidated made a model of a wing for its XB-46 bomber and tested the same in the wind-tunnel at the Massachusetts Institute of Technology, which test was one of those referred to in his patent in suit as demonstrating "convincingly that each of the objects of this invention has been fully achieved."

Garbell also admitted that while employed by Consolidated he suggested to it that it use his alleged invention in its Model 110 airplane being designed by Consolidated [R. 275, 466-467]. A full sized Model 110 airplane was completed and extensively flight-tested by Consolidated after Garbell left its employ [R. 416-419], the actual flight tests of such Model 110 being recorded in Exhibit 35. Such Exhibit 35 shows the many changes and struc-

tural modifications made by Consolidated in the wing and accessories therefor before it could obtain satisfactory flying results with such wing. As admitted by Garbell [R. 272], such accessories on a wing affect the aerodynamic results, thus indicating the necessity of full testing of an airplane wing to establish a reduction to practice thereof.

The wing of Consolidated's Model 110 airplane was later used by it in the "Convair" (Model 240) airplane [R. 418] which is here charged by petitioners to infringe the patent in suit. Garbell thus suggested to Consolidated while he was in its employ that it use substantially the identical wing which was ultimately used by it in its "Convair" airplanes here charged to infringe.

When Garbell was employed by Consolidated he executed an Invention Agreement, Exhibit 16 [R. 633], the pertinent provisions of which are as follows:

"1. The Employee agrees:

(a) To disclose promptly in writing to the Company's Patent Department or to such person as the Company may designate, all inventions and improvements heretofore or hereafter made, developed, perfected, devised or conceived by the Employee either solely or in collaboration with others during the Employee's employment by the Company, whether or not during regular working hours, and including a period of one (1) year after termination of employment, relating to aircraft or parts and the manufacture thereof, or relating in any way to aviation or to the business, developments or products of the Company; . . .

6. If the Company shall fail to elect in writing that it desires to prosecute a patent application on

any invention or improvement specified in paragraph 1 hereof within nine months following the complete disclosure thereof to the Company, then all rights of the Company in and to such invention or improvement shall revert to the Employee with the exception only that the Company shall have a free shop right with respect thereto."

On December 20, 1944, while he was employed by Consolidated, Garbell delivered to its Patent Department a paper, Exhibit D [R. 775], which set forth the alleged invention of the patent in suit [R. 269-270], together with a covering memoranda, Exhibit E [R. 789], the latter being signed by Garbell and stating:

> "Please consider this paper an official disclosure of invention. I shall be glad to complete the disclosure with any additional material that may be requested by you."

By memorandum dated January 8, 1945, Exhibit F [R. 790], the Consolidated Patent Department requested additional information from Garbell as to his said disclosure. Such information was never provided by Garbell.

There is no evidence in the record that Garbell ever at any time while he was employed by Consolidated made any claim, in substance or effect, that his alleged invention in suit was his separate property, or that he expected Consolidated to treat it as such, or that he had any claim adverse to Consolidated with respect thereto. At no time while employed by Consolidated did Garbell raise any objection to its use of the alleged invention in suit, and, to the contrary, at all times urged Consolidated to adopt and use the invention (Pet. p. 33).

The nature of Garbell's employment by Consolidated and the variety and responsibility of his duties while so employed are important to note. Garbell's initial telegraphic application for employment [R. 617] stated: "Can you offer advanced field of activity of experienced aeronautical engineer. Well versed in airplane and engine design, performance analysis and research. Have three successful original designs to my credit." Garbell's follow up [R. 619] of his initial telegram stated: "I am primarily interested in being placed where my ability may find its greatest usefulness in your organization, namely preliminary design or research engineering." This correspondence clearly shows that Garbell was seeking employment in which he could design *airplanes.*

Garbell's first work for Consolidated was design work in connection with aircraft [R. 216]. Garbell was originally employed as an "Aerodynamics Engineer A," and effective November 1, 1943, he was promoted to "Design Engineer" [R. 802, 804], the change being made for a *"Merit Increase."* Effective March 16, 1944, he was promoted to "Group Engineer," and effective February 1, 1945, he was promoted to "Design Specialist A" [R. 803]. Exhibit I [R. 801] and the portions thereof entitled "Stability and Control," "Special Projects," and "Prediction of Compressibility Effects" list the typical duties of Garbell while employed by Consolidated [R. 297], which plainly indicates that Garbell's duties included work on "new designs" of airfoils, wind-tunnel reports, test predictions, and related subjects pertaining to aircraft and aircraft wings. As a part of his duties, Garbell was not only working on the design of aircraft but in such work had under his supervision and control

eight engineers, as is shown by Exhibit H [R. 800, 396]. Garbell was obviously employed by Consolidated to design and test wings for aircraft, and the record in this case shows that he did so practically throughout this employment.

Garbell's salary was raised by Consolidated *after* his initial written suggestion with regard to and work on the testing of the "Two-Engine Tailless" airplane early in 1944, and his disclosure of invention in December, 1944. Thus, on May 1, 1944, he was a Group Engineer and his semi-monthly wage was increased from $247.50 to $267.50 [R. 803]. Again on February 1, 1945, he was promoted from Group Engineer to Design Specialist and his semi-monthly wage was raised from $267.50 to $285.00 [R. 803].

The Court of Appeals held that "During his employment by Consolidated, Garbell disclosed his alleged invention to Consolidated" [R. 1143], which is in accord with Finding of Fact XXXVII of the District Court [R. 53].

The Court of Appeals held that Consolidated did not waive the shop-right provided to it by paragraph 6 of the Invention Agreement between it and Garbell [R. 1143] and that: "The District Court did not find, nor did the evidence warrant a finding, that Consolidated ever 'rejected' or waived that shop right" [R. 1147].

The Court of Appeals held that the findings of the District Court that Garbell made, developed, and per-

fected his alleged invention prior to his employment by Consolidated "were not supported by evidence and were clearly erroneous" [R. 1145], holding that "the evidence showed that if Garbell ever made, developed or perfected his alleged invention, he did so during his employment by Consolidated" [R. 1146].

The Court of Appeals held an invention is not "made, developed or perfected until reduced to practice" and that "There was no evidence that Garbell reduced his alleged invention to practice prior to his employment by Consolidated. Instead, the evidence showed that, if he ever reduced it to practice, he did so during the employment" [R. 1146]. The Court of Appeals held that "if Garbell ever made, developed or perfected his alleged invention, he did so by and through the use of materials and facilities of Consolidated and time for which he was paid by Consolidated" [R. 1147].

The record in this action, for example as referred to above, clearly shows that all of the evidence in this action clearly supports the decision of the Court of Appeals.

D. Question Presented.

Although the Petition (p. 15) states *four* alleged "questions," actually there is only *one* question presented by the Petition, as follows:

> Do the facts in this case justify the Court of Appeals decision reversing the District Court on factual issues?

E. The Argument.

(a) In General.

The only questions presented by the Petition are as to the facts and the inferences to be drawn from the facts. This Court has uniformly denied petitions for certiorari where, as here, the only questions presented are factual. (*General Talking Pictures Co. v. Western Electric Co.*, 304 U. S. 175, 178, 58 S. Ct. 849, 82 L. Ed. 1273; *Fields v. United States*, 204 U. S. 291, 27 S. Ct. 281, 51 L. Ed. 490.) The Petition should be denied on this ground alone.

This action for patent infringement prays for a permanent injunction [R. 4] and such injunction has been ordered by the District Court [R. 59]. This is an action in equity, and in such an action "the review, unlike that on a writ of error at law, extends to the findings of fact as well as to the rulings on questions of law." (*See: Panama Mail S. S. Co. v. Vargas*, 281 U. S. 670, 50 S. Ct. 448, 74 L. Ed. 1105; *Keller v. Potomac Electric Power Co.*, 261 U. S. 428, 43 S. Ct. 445, 67 L. Ed. 731.)

The Court of Appeals, having clearly in mind [R. 1146] the requirements of Rule 52(a) of the Rules of Civil Procedure, had the record before it as to both the facts and the law, and under the foregoing authorities had full power to reverse the District Court on its findings of fact.

The Petition relies heavily upon *United States v. United States Gypsum Co.*, 333 U. S. 364, 68 S. Ct. 525, 92 L. Ed. 746. However, petitioners can find no comfort in that case because there this Court held that certain findings of fact of the District Court were "clearly erroneous," just as the Court of Appeals has done here.

The *Gypsum Co.* case, *supra,* in fact is direct support for the decision of the Court of Appeals in this case, as, obviously, the Court of Appeals here, after a careful review of the whole record in this case, was "left with a definite and firm conviction that a mistake has been committed" by the District Court. The decision of the Court of Appeals in the present case was unanimous.

Consolidated could have acquired the entire legal title to Garbell's alleged invention in suit under the Invention Agreement, Exhibit 16 [R. 623] by paying him not to exceed $100.00. Or it could have asserted title thereto under the doctrine of *Standard Parts Co. v. Peck,* 264 U. S. 52. It has done neither, leaving title in Garbell, for him to enjoy the patent in suit against the whole world other than respondents. All that Consolidated claims is a shop-right to free it from the inequitable claim made here by Garbell.

(b) Respondents Have an Express License Under the Patent in Suit.

The Court of Appeals held [R. 1145-1146] that respondents have an *express* license (*i. e.,* shop-right) under the Garbell patent in suit under the Invention Agreement, Exhibit 16 [R. 633], because the alleged invention was reduced to practice (*i. e.,* "made, developed, or perfected") while Garbell was employed by Consolidated, as contemplated by the Invention Agreement. Such holding is manifestly correct and is fully supported by the evidence.

Petitioners argue (pp. 7-9, 17, 50) that, because Garbell did not adequately comply with his obligations under the Invention Agreement as to disclosure to Consolidated of the alleged invention in suit, Consolidated acquired no shop-right or license under the Invention Agreement. This

is a curious contention. How a party to a contract could defeat the rights of the other contracting party thereto simply by failing or refusing to comply with his obligations does not appear to us. In any event, the acquisition of a shop-right by Consolidated under the Invention Agreement is not conditioned in any way upon Garbell disclosing the alleged invention to Consolidated, and since the invention was reduced to practice while Garbell was so employed the requirements of the Agreement were satisfied at least insofar as the shop-right to Consolidated is concerned and the shop-right is absolute.

However, Garbell made a disclosure of the alleged invention by his paper, Exhibit D [R. 775], to the Patent Department of Consolidated, exactly as required by Paragraph 1 of the Invention Agreement. Furthermore, Garbell expressly characterized such "paper" as an "official disclosure of invention" by his accompanying memo, Exhibit E [R. 789]. Thus, Garbell himself construed his alleged invention in suit as falling within the terms of the Invention Agreement. The actions of the parties construing a contract should be followed by the courts in construing a contract. (*District of Columbia v. Gallaher,* 124 U. S. 505, 31 L. Ed. 526, 527; *Mitau v. Roddan,* 149 Cal. 14, 84 Pac. 145, 6 L. R. A. 275, 281.)

The only question seriously raised by petitioners in whether the alleged invention in suit was "made, developed or perfected" [Par. 1 of the Invention Agreement] while Garbell was employed by Consolidated, and this is a purely factual question.

The Court of Appeals [R. 1146] held that an invention is not "made, developed, or perfected until reduced to practice," citing the authority of this Court and other courts. Petitioners admit (p. 28) that this statement of

the law is correct in many types of patent cases, including those in which the defendants are "seeking any title to or interest in the invention or patent." Petitioners seek to avoid the application of such legal principle to the facts of this case by contending that here the respondents are not "seeking any title to or interest in the invention or patents" but without the citation of any authority in support thereof. Such contention of petitioners is obviously without merit. Respondents claim a non-exclusive license (shop-right) under the Garbell patent in suit, and, obviously, a non-exclusive license is a limited interest in the monopoly of the patent in suit. (*Waterman v. Mackenzie,* 138 U. S. 252, 11 S. Ct. 334, 34 L. Ed. 923; *Bloomer v. McQuewan,* 55 U. S. 539, 14 L. Ed. 532.)

Petitioners do not contend that Garbell's alleged invention in suit was actually reduced to practice prior to his employment by Consolidated. They could not do so, because there is no evidence to support such a contention and, in fact, Garbell stated in effect that up until the time of trial of this action neither he nor anyone else with his consent had ever built an airplane wing embodying his alleged invention in suit [R. 238-239].

Petitioners attempt to avoid the consequences of the above principle of law stated by the Court of Appeals, by contending (pp. 11 and 44) that Garbell's mere conception or oral disclosure of the invention prior to his employment by Consolidated was a "constructive reduction to practice" of the invention. In support of this contention, petitioners cited *Curtiss Aeroplane & Motor Corp. v. Janin,* 278 Fed. 454 (C. A. 2d), which is not in point, as in that case the Court actually held that

even the filing of a patent application was not a reduction to practice.

The case of *Heywood-Wakefield Co. v. Small,* 87 F. 2d 716 (C. A. 1st), largely relied upon by petitioners, is clearly distinguishable on its facts from the present case and is not in point. In that case, the inventor Small on his own time conceived and built an adequate model of the invention there in suit, and, the Court held, that no further testing of any kind was required to demonstrate that the invention was in practical commercial form. That is not true in the present case because, as plainly stated in the Garbell patent in suit and Garbell's admissions (p. 7, *supra*), it was the extensive building and testing of models of the "Two-Engine Tailless" and the XB-46 by Consolidated that "demonstrated convincingly that each of the objects of this invention has been fully achieved." Furthermore, as pointed out by the Court in the *Heywood-Wakefield* case, *supra,* Small did not stand by for a long period of time and permit his employer to use his invention *without protest* (as in *Gill v. United States,* for example). Largely determinative of the case was the fact that the inventor Small immediately upon disclosure of his invention to his employer demanded payment for the employer's use of it, and at all times there was a controversy between Small and his employer as to whether Small or the employer was to have the rights to the invention. No such situation is presented in this action, as here Garbell at no time while he was employed by Consolidated made any claim that the alleged invention here in suit was his separate property or that he was entitled to any payment from Consolidated for its extensive use and planned use of the alleged invention in its "Two-Engine Tailless," XB-46, and Model 110 air-

planes in all of which Garbell had expressly suggested that Consolidated use the alleged invention in suit.

There is no authority for such a contention as petitioners urge and it is contrary to all of the established law to the effect that an invention is not made (*i. e.*, reduced to practice) until embodied in some concrete physical form. As stated by this Court in *Clark Thread Co. v. Willimantic Linen Co.*, 140 U. S. 481, 11 S. Ct. 846, 35 L. Ed. 521:

> "It is evident that the invention was not completed until the construction of the machine. A conception of the mind is not an invention until represented in some physical form . . ."

The distinction between conception and reduction to practice of an invention, and the necessity of the invention being embodied in tangible form, was reiterated by this Court in *United States v. Dubilier Condenser Corp.*, 289 U. S. 178, 53 S. Ct. 554, 77 L. Ed. 1114, 1119, as follows:

> "It [the invention] is the result of an inventive act, the birth of an idea *and* its reduction to practice; the product of original thought; a concept *demonstrated to be true by practical application or embodiment in tangible form.* Clark Thread Co. v. Willimantic Linen Co., 140 U. S. 481, 489, 35 L. Ed. 521, 525, 11 S. Ct. 846, T. H. Symington Co. v. National Castings Co., 250 U. S. 383, 386, 63 L. Ed. 1045, 1049, 39 S. Ct. 542; Pyrene Mfg. Co. v. Boyce (C. C. A. 3rd), 292 Fed. 480, 481." (Emphasis added.)

The evidence, as reviewed above (p. 4-7), plainly shows that actual models of wings for the "Two-Engine Tailless" airplane, incorporating Garbell's alleged inven-

tion in suit were made by Consolidated and extensively tested by it with the full knowledge and consent of Garbell during his employment. Consolidated's reports signed by Garbell and covering such tests showed that such tests demonstrated the practicability of his alleged invention, and the Garbell patent in suit plainly states in effect that the models and tests made by Consolidated "demonstrated convincingly that each of the objects of this invention has been fully achieved" (see p. 7, *supra*).

In addition, Garbell in his suggestion dated March 2, 1945, that Consolidated employ his alleged invention in suit in its Model 37 airplane, Exhibit 25 [R. 666], expressly admitted that his alleged invention had *previously* been embodied in the various *earlier* airplane designs of Consolidated, as follows:

> "The 'tri-section wing' principle which has been successfully applied to the Tailless design, the executive transport, and the XB-46 design, yields several satisfactory wings."

Such Exhibit 25 was held by the District Court to be a disclosure of the alleged invention in suit to Consolidated [R. 40]. In view of its express statement, quoted above, by Garbell at the time and on the spot and long prior to any controversy, there can be no doubt that Garbell's alleged invention had been embodied by Consolidated in its "Two-Engine Tailless," its executive transport, and its XB-46 bomber at least as early as March 2, 1945, with Garbell's full knowledge. Obviously, Garbell's alleged invention was thereby reduced to practice

by Consolidated while he was employed by it and with his full knowledge and approval.

Petitioners argue (pp. 9-10) that while inventions for processes, machines, or designs may require embodiment in physical form before they are complete, the alleged invention here in suit "is not one which calls for a process or machine or design." The Garbell patent in suit was obtained under old Section 31 of Title 35, United States Code, which made provision for patents only on an "art, machine, manufacture, or composition of matter . . . [and] asexually reproduced . . . plant." If the airplane wing of the Garbell patent here in suit is not a "machine" within the statute, we do not know what it is. Certainly, it is not an art, manufacture, composition of matter, or a plant. We suggest that petitioners' admission (p. 10) that inventions for machines "usually need work and trial-and-error methods, models need to be made," etc., applies directly to a complex structure such as Garbell's alleged invention in suit.

It is thus plain that: (a) there is clear evidence in the record to support the decision of the Court of Appeals that the alleged invention in suit was reduced to practice while Garbell was employed by Consolidated and is therefore within the Invention Agreement and respondents have an express shop-right with respect thereto; and (b) there is no evidence to support the Finding of the District Court that the alleged invention in suit was "made" (as distinguished from its "conception"), prior to Garbell's employment by Consolidated, and such Finding is clearly erroneous.

(c) Respondents Have an Implied License Under the Patent in Suit.

The Court of Appeals further held [R. 1147] that respondents have an *implied in law* license (*i. e.*, shop-right) under the Garbell patent in suit, in view of the fact that Garbell's alleged invention was reduced to practice by him (if ever) while he was employed by Consolidated "by and through the use of materials and facilities of Consolidated and time for which he was paid by Consolidated." This implied in law license, the Court of Appeals pointed out, existed irrespective of the Invention Agreement.

That the alleged invention in suit was reduced to practice while Garbell was employed by Consolidated has been pointed out above (p. 16-20).

Petitioners contend, in effect (pp. 12, 45), that there is no evidence in the record that the work done by Consolidated with regard to Garbell's alleged invention while he was employed by it cost Consolidated anything. Such contention is either flatly wrong, highly misleading, or we misunderstand petitioners' argument. As pointed out above (p. 4-9), an enormous amount of work was done by Consolidated in making and testing models of its "Two-Engine Tailless" and XB-46 airplanes while Garbell was employed by it with his full knowledge, consent, and direct cooperation. One of his reports (p. 6, above) indicates that certain of the models of the "Two-Engine Tailless" airplane require *3500* man-hours of work each in its building. Other Consolidated engineers (Fiul, Rogers, Strohmeyer and Bayless) devoted company time to utilizing and testing Garbell's alleged invention in suit [R. 309, 697, 1007] while he was likewise so occupied. Could any court be asked seriously to believe that all of

such construction work and the extensive wind-tunnel testing of the models was without substantial cost to Consolidated? We think not. In any event, Garbell freely admitted that everything in issue done at Consolidated was done at its expense, as follows:

"The Court: As a matter of fact, all the experiments, or whatever you call them, these tests, were done as a part of the work and progress of the concern, isn't that true?

The Witness: (Pause.)

The Court: Do you know what I mean by 'work and progress'? That is used in engineering, it is also used in literature. When you have a thing in a preliminary stage and you just keep on working on it.

The Witness: Yes, your Honor, but—

The Court: I don't mean to catch you by the question.

The Witness: No, I want to make myself very clear though.

The Court: I am trying to shorten this by getting an answer that will end it. Whatever was done, was done at company expense, assuming that it required expense, these experiments, these wind tunnel tests, or whatever was done.

Mr. Gerlach: The preparation.

The Court: The preparation of the report or whatever was done, was done on company time, and where it required money, with company money, isn't that true?

The Witness: Yes, but especially during all of the early suggestions and urgings they were completely outside of my assignments, my direct work assignments.

The Court: Work that you did yourself?

The Witness: Yes.

The Court: I am not interested in that. I know what is bothering you. I know your type very well. What is bothering you is the idea that all of this was conceived before this was done, isn't that true?

The Witness: And it was proposed and suggested outside of the work assignments in a general sense.

The Court: That is all right.

The Witness: I wasn't working on those at all.

The Court: But whatever they did, whether they gave directions or not, they did it at their expense, whatever the expense was, isn't that true?

The Witness: It was theirs or the contracting agencies." [R. 264-265, and see 262-263.]

We therefore suggest that, as stated by the Court of Appeals, if Garbell's alleged invention was ever made, developed or perfected it was done so while he was employed by Consolidated with its time, materials, and facilities at its expense and with his full knowledge and consent.

In finding such implied in law license in respondent Consolidated the Court of Appeals relied upon a number of decisions of this Court in footnote 1 [R. 1143] and footnote 9 [R. 1147]. Petitioners do not question the applicability of such decisions to the facts of this action, citing (p. 18) *Gill v. United States*, 160 U. S. 426, 16 S. Ct. 322, 40 L. Ed. 480; *United States v. Dubilier Condenser Corp.*, 289 U. S. 178, 53 S. Ct. 554, 77 L. Ed. 1114; and *Solomons v. United States*, 137 U. S. 342, 11

S. Ct. 88, 34 L. Ed. 667. Petitioners quote with approval from *Gill v. United States, supra,* as follows:

> "The principle is really an application or outgrowth of the law of estoppel *in pais,* by which a person looking on and assenting to that which he has power to prevent is held to be precluded ever afterwards from maintaining an action for damages."

The applicability of such legal principle stated in the *Gill* case, *supra,* to the facts of this action is obvious. Here, Garbell looked on, assented to, and encouraged Consolidated to adopt and use his alleged invention in suit, it allegedly did so and is now sued for patent infringement as a result of such use. If there ever has been a situation where the doctrine of estoppel *in pais* should be applied it is in this case.

Petitioners (pp. 17-18, 27) attempt to define the "shop-right rule" but such definition does not consider the plain language of this Court's decisions which petitioners cite and rely upon, inserting additional requirements that such decisions of this Court do not mention. The true "shop-right rule" was stated by this Court in the *Gill* case, *supra,* at page 429, as follows:

> "'[Can] an employee paid by salary or wages, who devises an improved method of doing his work, using the property or labor of his employer to put his invention into practical form, and assenting to the use of such improvements by his employer, . . . by taking out a patent upon such invention, recover a royalty or other compensation for such use. In a series of cases . . . we have held that this could not be done."

The facts of this case are clearly within the shop-right rule as applied by this Court in *Gill v. United States, supra; United States v. Dubilier Condenser Corp., supra; McClurg v. Kingsland,* I How. 202; *Solomons v. United States, supra;* and *Lane & Bodley Co. v. Locke,* 150 U. S. 193. Upon the authority of such cases, and the additional decisions cited by the Court of Appeals in its opinion, Consolidated plainly has a shop-right under the Garbell patent here in suit and the Petition should be denied.

Also directly in point is the case of *Tin Decorating Co. v. Metal Package Corporation,* 29 F. 2d 1006 (D. Ct., N. Y., 1928), affd. at 37 F. 2d 5 (C. C. A. 2d), and cert. den. at 281 U. S. 759, 74 L. Ed. 1168, in which an invention was conceived by an employee prior to his employment but reduced to practice by the employer during employment and upon which a patent application was filed by the employee after his employment was terminated. (To the same effect, *Elzilaw Co. v. Knoxville Glove Co.,* 22 F. 2d 962 (C. C. A. 2d).)

F. Conclusion.

This is a run-of-the-mill action for patent infringement. The public interest has been served by the decision of the Court of Appeals holding that the respondents are free of the monopoly of the patent in suit and insuring that the Convair airplanes in wide commercial service may continue to serve without interruption the air-traveling public.

Petitioners' Brief is almost entirely a verbatim copy of their petition for rehearing addressed to the Court of Appeals, and advances here no question of law or fact not considered by the Court of Appeals.

The only questions raised by the Petition are purely factual. There is no question presented by the Petition requiring or deserving the consideration of this Court.

It is submitted that the Petition should be denied.

Respectfully submitted,

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